

***United States Court of Appeals
for the
District of Columbia Circuit***



**TRANSCRIPT OF
RECORD**

Defective Copy *Pages 74 to 91 out*

**BRIEF FOR APPELLANT AND
JOINT APPENDIX**

IN THE
United States Court of Appeals

DISTRICT OF COLUMBIA.

No. 8710

585

UNITED STATES RUBBER COMPANY, a Corporation
organized under the laws of the State of New Jersey,
Appellant,

v.

CONWAY P. COE, Commissioner of Patents and/or his
successor in office, *Appellee.*

Appeal from the District Court of the United States for the
District of Columbia.

GIFFORD, SCULL & BURGESS,
141 Broadway,
New York, N. Y.,
Attorneys for Plaintiff-Appellant.

NEWTON A. BURGESS,
LESTER G. BUDLONG,
RALPH B. STEWART,
National Press Bldg.,
Washington, D. C.
Of Counsel.

UNITED STATES
COURT OF APPEALS FOR THE
DISTRICT OF COLUMBIA

FILED JUN 27 1944

PRESS OF BYRON S. ADAMS, WASHINGTON, D. C.

Joseph W. Stewart
CLERK

4-51

INDEX TO BRIEF FOR APPELLANT.

	Page
Jurisdictional Statement	1
Statement of Case	2
Statement of Points	5
Summary of Argument	5
Argument	7
Historical	7
The Device in Suit	9
The Patents to Knight, Sahuc, and French Patent Do Not Disclose the Subject Matter of the Claims in Suit	10
Knight 1,471,172	10
Sahuc 1,475,544	11
French Patent 543,050	12
The Findings of Invalidity are Not Supported by Any Evidence	12
The Claims in Suit are Not Invalid Over Watson...	13
The Legal Question Involved	16
There is no estoppel by judgment	17
There is no other estoppel	18
Plaintiff is entitled to the claims in suit.....	19
Statutes Involved	24

CASES CITED.

<i>American Cyanamid Co. et al. v. Coe</i> , 70 App. D. C. 330; 106 Fed. (2d) 851	18, 19
<i>Blackford v. Wilder</i> , 28 App. D. C. 535; 1907 C. D. 491	15, 17
<i>Daniels v. Coe</i> , 73 App. D. C. 54; 1940 C. D. 33.....	15, 17
<i>In re Long</i> , 83 Fed. (2d) 458, 463, 464.....	19, 20, 21
<i>In re Thomas</i> , 8 U. S. P. Q. 90	21, 22
<i>In re Wasserfallen</i> , 54 App. D. C. 367; 1924 C. D. 326	15, 17
<i>International Cellucotton Products Co. v. Coe</i> , 66 App. D. C. 248; 85 Fed. (2d) 869	18, 19
<i>Tinnerman Products, Inc., et al. v. Coe</i> , 50 Fed. Supp. 337, decided June 9, 1943	18
<i>Walker on Patents</i> , Deller 1937 Edition, page 298....	22

IN THE
United States Court of Appeals

DISTRICT OF COLUMBIA.

No. 8710.

UNITED STATES RUBBER COMPANY, a Corporation
organized under the laws of the State of New Jersey,
Appellant,

v.

CONWAY P. COE, Commissioner of Patents and/or his
successor in office, *Appellee.*

**Appeal from the District Court of the United States for
the District of Columbia.**

BRIEF FOR APPELLANT.

JURISDICTIONAL STATEMENT.

This is an appeal from a final judgment of the United States District Court for the District of Columbia dismissing the complaint in the above-entitled case. The action was brought under the provisions of Revised Statutes 4915

(Title 35, Sec. 63 of the Code of Laws of the United States) against the Commissioner of Patents to authorize the grant of a patent.

The pertinent section of the statutes involving jurisdiction is set forth on page 24 of this brief.

STATEMENT OF CASE.

Appellant was refused a patent by the Board of Appeals on the claims quoted below from the application of Ernst Eger, Ser. No. 635,209, filed September 28, 1932.

Claim 24. A valve stem comprising a molded body of flexible material having base and tip portions and an axial air passage extending therethrough from the base to the tip portions, said body having a restricted portion sloping inwardly of the passage and toward the tip portion providing an inwardly tapering surface forming a valve seat, a valve element disposed in the passage and having a conical surface for engaging the tapering body surface, metallic means associated with the stem exteriorly of the body seat and serving as a reenforcement for said seat, a pin carried by the valve element and extending longitudinally of the passage toward the stem tip, and a metallic spring associated with said pin and disposed within and operatively supported by said metallic means for urging the valve element to its closed position to cause passage sealing engagement between said tapering and conical surfaces.

Claim 25. A valve stem comprising a molded body of flexible rubber composition having base and tip portions and an axial air passage extending therethrough from the base to the tip portions, said body having a restricted portion sloping inwardly of the passage and toward the tip portion providing an inwardly tapering surface forming a valve seat, a valve element disposed in the passage and having a conical surface for engaging the tapering body surface, metallic means associated with the stem exteriorly of the body seat and serving as a reenforcement for said seat, a pin carried by the valve element and extending longitudinally of the passage toward the stem tip, and a metallic spring

associated with said pin and disposed within and operatively supported by said metallic means for urging the valve element to its closed position to cause passage sealing engagement between said tapering and conical surfaces.

Claim 26. A valve stem comprising a molded body of flexible material having base and tip portions and an axial air passage extending therethrough from the base to the tip portions, said body having a restricted portion sloping inwardly of the passage and toward the tip portion providing an inwardly tapering surface forming a valve seat, a valve element disposed in the passage and having a conical surface for engaging the tapering body surface, metallic means associated with the stem exteriorly of the body seat and serving as a reenforcement for said seat, a pin carried by the valve element and extending longitudinally of the passage toward the stem tip, and a metallic spring enclosing said pin and disposed within and operatively supported by said metallic means for urging the valve element to its closed position to cause passage sealing engagement between said tapering and conical surfaces.

Claim 27. A valve stem comprising a molded body of flexible material having base and tip portions and an axial air passage extending therethrough from the base to the tip portions, said body having a restricted portion sloping inwardly of the passage and toward the tip portion providing an inwardly tapering surface forming a valve seat, a valve element disposed in the passage and having a conical surface for engaging the tapering body surface, metallic means associated with the stem exteriorly of the body seat and serving as a reenforcement for said seat, a pin carried by the valve element and extending longitudinally of the passage toward the stem tip, a metallic spring enclosing said pin and disposed within and operatively supported by said metallic means for urging the valve element to its closed position to cause passage sealing engagement between said tapering and conical surfaces, and a spring seat carried by the pin for imparting longitudinal movement thereto.

Claim 28. A valve stem comprising a molded body of flexible material having base and tip portions and an axial air passage extending therethrough from the base to the tip portions, said body having a restricted portion sloping inwardly of the passage and toward the tip portion providing an inwardly tapering surface forming a valve seat, a valve element disposed in the passage and having a conical surface for engaging the tapering body surface, metallic means associated with the stem exteriorly of the body seat and serving as a reenforcement for said seat, a pin carried by the valve element and extending longitudinally of the passage toward the stem tip, a metallic spring enclosing said pin above said valve element and disposed within and operatively supported by said metallic means for urging the valve element to its closed position to cause passage sealing engagement between said tapering and conical surfaces, and a spring seat carried by the pin for imparting longitudinal movement thereto.

The Commissioner denied the patentability of the above claims in view of the French patent 543,850 and U. S. patents to Knight 1,471,172 and to Sahuc 1,475,554; also in view of patents to Watson 2,106,671 and 2,200,785 (App. p. 8).

At the trial Mr. Raymond F. Ternes testified for Eger that the valve stems constituting the subject matter of the claims in suit had many points of advantage over those disclosed in the French patent and the U. S. patents to Knight and Sahuc; also that to his knowledge Eger had completed his invention by making a model thereof, and that the application for patent involved in this suit had been drafted and the drawings therefor made as early as July 1, 1932, prior to the effective filing date of either of the Watson patents; also that because of an agreement signed by Watson in his (Ternes') presence, Watson conceded that the invention of the claims in suit belong to Eger and not to him (Watson).

No testimony was offered on behalf of the Commissioner.

STATEMENT OF POINTS.

The points on which appellant intends to rely are:

1. The claims in suit are patentable over the French patent and the U. S. patents to Knight and to Sahuc cited by the Examiner. These claims were allowed by the Examiner in his letter of February 10, 1941 (App. p. 42). There is no evidence in the case to show that the claims are anticipated by these patents. On the contrary, the evidence shows clearly that there are important differences between the structure of the claims in suit and the disclosure of each of these three patents or any legitimate combination of such patents.

2. That the Watson patents are unavailable as references against the claims in suit because

(a) Watson has conceded in a signed statement (Plaintiff's Exhibit 1, App. p. 31) that he was not the inventor of two important features of each of the claims in suit and

(b) the evidence shows that Eger had completed his invention as early as July 1, 1932, earlier than any effective filing date of the Watson patents.

3. That there is no estoppel against Eger arising out of an interference 69,225 between Watson and Eger, because none of the claims in suit could have been made by Watson and therefore could not have been counts of an interference between Watson and Eger. It was conceded at the trial that the claims in suit could not have been counts of an interference between Watson and Eger.

SUMMARY OF ARGUMENT.

Appellant urges the patentability of the claims in suit on the following grounds:

1. There are certain practical advantages in providing valve stems for automobile tires which have maximum flexi-

bility and which can be attached to the inner tube by vulcanization, thus creating the best possible leak-proof joint between the valve stem and the inner tube; also there are certain advantages in using the inner portion of the rubber valve stem as a valve seat for a metallic conical valve; also that there are certain advantages in placing the valve spring above or outside of the valve seat so as to avoid breakage or disarrangement of the valve parts when the valve stem is flexed or, in other words, to afford maximum flexibility of the valve stem without injury to or displacement of the parts.

2. The claims in suit, which call for a device having the advantages in (1) above, are patentable over the French patent and the U. S. patents to Knight and to Sahuc because there is no disclosure in either of these three patents except an all-metal valve or an all-metal attachment for an all-metal valve. Therefore these patents do not disclose a device having any flexibility nor can the device be attached to the inner tube by vulcanization, nor can the valve be readily assembled or disassembled without removing it from the inner tube. Consequently there is no teaching in any of these three patents of the various advantages recited in (1) above. There is no testimony tending to show that the claims are invalid in view of these three patents. On the contrary, all the evidence is that the claims in suit are not invalid in view of these three patents.

3. That the Watson patents are unavailable as prior art against the claims in suit despite the fact that there was an interference on a different subject matter between Watson and Eger. The claims in suit concededly could not have been made counts of an interference between Watson and Eger and, additionally, Watson, by a signed statement (Plaintiff's Exhibit 1, App. p. 31), agreed that two features of each of the claims in suit (namely, the conical valve and the placing of the valve spring outside of the valve seat) belonged to Eger and not to himself. Thus, in effect, he disclaimed these two features.

4. That the proofs clearly show that there can be no estoppel against Eger arising out of the interference for the reason that the claims in suit could not have been counts of an interference with Watson and because Watson has agreed that he is not the inventor of two elements or features of each claim in suit.

5. That the proofs clearly show that Eger had completed his invention prior to the filing date of either of the Watson patents relied upon and, since there can be no estoppel for the reasons stated in (4) above, it follows that the Watson patents are not available as prior art against the claims in suit.

ARGUMENT.

Historical.

The Eger application while in the Patent Office was involved in an interference 69,225 with an application of F. H. Watson. The sole count of that interference read as follows:

"In a pneumatic tire valve and stem, a stem member connected with a pneumatic tube including a bore therethrough and a chamber formed intermediate the ends of said bore, the walls of said chamber and bore being yieldable, a body element axially shiftable relative to said stem including a valve head of greater diameter than said bore and less in diameter than said chamber, said valve head adapted to seal said stem member when forced into said bore and permit flow of air through said valve stem when in said chamber, and a cap member secured to said body element and embracing the extended portion of said stem."

The interference on the above count terminated in favor of Watson primarily on the ground that Eger could not make the count (104 F. (2d) 953-6), but, as will be noted by comparing the count with the claims in this suit, it related to a different specific subject matter from the claims involved here.

After the interference terminated, the claims of this suit were submitted in the Eger application and, in his letter of February 10, 1941, the Examiner allowed all of them (App. p. 42).

On April 3, 1941, the Examiner stated:

"The above identified application has been withdrawn from issue because of claims 24 to 28, inclusive, which were inadvertently allowed over the Watson patent 2,106,671."

This Watson patent is the main reference relied upon by the Patent Office in this suit. Another Watson patent No. 2,200,785, is cited in the answer (App. p. 8), but the Examiner agreed (App. p. 60) that Fig. 5 of patent 2,200,785 is the same as Fig. 12 of patent 2,106,671 and therefore the former patent need not be further considered.

The Commissioner also cites (App. p. 8) French patent 543,850, and U. S. patents to Knight 1,471,172, and to Sahuc 1,475,554.

Mr. Ternes testified for plaintiff and no one testified for the Commissioner.

As appears from his testimony (App. pp. 11-12), Mr. Ternes is well qualified to testify on this subject because of his experience. He was a machine designer in the Engineering Department of plaintiff for three or four years and then became associated with patent work which he has followed for some seventeen years. He has been located at the Detroit plant which is principally devoted to the making of automobile tires and substantially all of his experience has been connected with respect to tires and tire equipment. His practice has been to follow the new ideas through the development stage until they are taken over by the Sales Division and consequently he became familiar with the various problems involved in the design of tires and valves and other matters related to this subject. In view of this long experience and his intimate contact with this subject matter from the development and practical angles,

it is submitted that Mr. Ternes' testimony is worthy of complete acceptance.

Ternes discussed the French, Knight, and Sahuc patents (App. pp. 20 to 26 and 30) and pointed out wherein each of them fails to disclose the claims in suit. After hearing this testimony, the trial court appeared to agree (App. pp. 26-27) that the claims were not anticipated by these patents.

The Device in Suit.

The device in suit as shown and described in the Eger application (App. pp. 35-38) may be described as follows:

The claimed invention relates to a rubber valve stem (1) in which the stationary valve seat (13) is formed by an inwardly projecting portion or constriction in the body of the stem rubber; a metal reenforcement (4) is provided externally of the body seat (13); a metallic valve element (16) of a conical shape cooperates with the rubber body seat (13); a pin (15) extending upwardly through the body seat; a spring (17) surrounding the pin and urging the valve (16) to its closed position by engaging a flange (19) and a rim (18) for one of the springs. It is important to note that in this construction, the closing spring (17) is placed in the valve stem bore above the stationary body valve seat (13).

As pointed out by Ternes (App. pp. 22-23), the Eger application is correct in stating that it is important to place the spring 17 above the valve seat. This construction eliminates the need for large chambers and supporting elements deep within the valve bore. It also eliminates provision for supporting the lower end of the spring deep within the bore. By applicant's construction the spring is supported from the metal at the outer end of the stem by a ferrule or cap 4 which serves both to reenforce the valve seat and to support the valve element. As pointed out by Ternes (App. p. 23), it is important to have the valve stem flexible. The flexibility would be greatly limited if the spring were below or on the inside of the valve because of the danger of in-

juring or displacing the various elements of the valve mechanism upon the unavoidable flexing of the valve stem in use. With the spring and its supporting elements above or outside of the valve, the stem may be given almost unlimited flexibility because there is nothing below the valve to interfere with the flexibility or to be displaced or thrown out of operation thereby. While this might appear to be a minor matter, it is in fact very important because the reliability of the device in practice depends in great measure upon this feature. Obviously if the parts were arranged so that they were injured or thrown out of order by flexing the stem it would have little practical value, because one of the main reasons for using a rubber stem instead of metal is to secure the desired flexibility.

There is also a decided advantage, as pointed out by Ternes (App. p. 24), in using a conical valve, because it provides a long sloping area of engagement between the metal valve element and the rubber seat as contrasted with a spherical valve which produces a single line of contact.

Since all the claims are for a combination of elements it makes no difference whether or not each element individually is old.

The Patents to Knight, Sahuc, and French Patent Do Not Disclose the Subject Matter of the Claims in Suit.

As stated above, it is believed that the trial court agreed with plaintiff that the above patents, either singly or collectively, do not disclose the subject matter of the claims in suit. Before discussing the Watson patent and the legal questions involved in its consideration, we shall briefly discuss these other patents.

Knight 1,471,172.

This patent discloses an *attachment* to be screwed onto the end of the ordinary metal valve stem. The Knight device is an all metal structure in which a valve 9 is drawn

against the metallic seat 8 by the threads 17 of the cap 16 engaging the corresponding threads 10 on the valve stem. Being an all metal attachment for application to a metal valve stem, it does not utilize a rubber valve stem body and of course does not use the rubber body as a valve seat. There is no need for any reenforcement of the valve seat because of the use of metal and therefore the problem which was presented to Knight is entirely different from that solved by the applicant.

The sealing of the Knight valve is no better than can be produced by a machine fit between metallic parts. Such a delicate and accurate machining operation would require undue expense for such a low priced item, but, unless this high grade machining was done, the device would be utterly useless as it would not be air-tight. It does not have any of the flexibility of the Eger device and it is submitted that Knight does not disclose the subject matter of the claims.

Sahuc 1,475,544.

Here again the valve stem is all metal and does not have any of the desirable properties of a rubber stem in so far as attachment to the tube or flexibility are concerned. The valve seat is of metal and therefore needs no reenforcement and there is no spring provided to retain the valve on its seat, reliance being had solely upon the air pressure. Sahuc has the impracticable idea of forcing the caouthouc valve *D* down through the small opening *C* in the valve stem in order to assemble the device. It is quite obvious that after the valve has been in use for some period of time, the valve material would harden and it would be utterly impossible to remove it by pulling on the eye *F* of the valve stem *E*. As a matter of fact, the stem *E* would be stripped out of the valve *D*, leaving it in the chamber *B*, thus creating a condition which would certainly be calculated to prevent suitable operation of a new valve 7 pushed into place as was the original valve. The dirt that would remain in the chamber *B* as a result of trying to remove the first valve

would undoubtedly find its way to the valve seat, thus interfering with the operation of any new valve that might be put in place later. It seems clear that Sahuc does not disclose the features called for by the claims in suit.

French Patent 543,050.

Here also the valve stem is all metal, thus making it impossible to secure any of the advantages of the flexible rubber stem which could be attached by vulcanization to the tube as pointed out in the Eger application.

One form of the French device is an attachment to be screwed onto the usual metal stem, much like that of Knight. The other form of the French device is shown in Figs. 1, 2, 4, and 5 where he merely puts the valve down into the metal stem against a valve seat *B* with a spring below or on the inside of the valve. The Frenchman did not know how to arrange a *removable* valve without resorting to the attachment shown in Figs. 6, 7, and 8, thus showing that the simple arrangement of Eger providing for easy removal of the metal valve was not an obvious matter.

As pointed out in the Eger specification, the metal valve 16 may be placed in position and removed by merely pressing it past the rubber valve seat 13. This is quite different from the arrangement of Sahuc who proposed to push a *caoutchouc* valve past a *metal* valve seat. In Eger full flexibility of the rubber stem is secured by placing all of the operating parts outside of the valve 16. There is no disclosure of any such idea in the French patent and therefore it does not meet the claims in suit.

The Findings of Invalidity are not Supported by Any Evidence.

The Court below made findings (4, 5, 6 and 7) without any evidence to support such findings. In fact, all the evidence in the case was to the contrary. Therefore, these findings should be disregarded.

Watches -
219 F. 909,910
236 08 219

The Claims in Suit Are Not Invalid Over Watson.

Before discussing the Watson patent, it is important to note that Watson was in contact with plaintiff (Eger's assignee) prior to the time that the application for the Watson patent '671 was filed. An undisputed record of a meeting between Watson and certain employees of plaintiff is in evidence as Plaintiff's Exhibit 1 (App. p. 31). This meeting was held at Detroit and Mr. Ternes and Dr. Cadwell were present for plaintiff, and Mr. Watson and others were there also. At this meeting Watson displayed a drawing, which is in evidence as Plaintiff's Exhibit 2. An inspection of this drawing clearly shows that in every illustration the spring is below the valve and also that in every instance the valve is spherical. With this drawing in mind, it is perfectly clear what the parties meant by the following statement in the memorandum (Plaintiff's Exhibit 1):

"The main difference between the two ideas is that Mr. Eger has his spring above the sealing member and Mr. Watson proposes to put his below the sealing member. Mr. Watson's metal sealing member is spherical whereas Mr. Eger's is conical."

This memorandum also states that

"We in turn showed him Mr. Eger's drawing of a very similar invention on which a patent application has been submitted by us. This is the photostat of the drawing that was submitted with the patent application."

As pointed out by Ternes (App. p. 19), the Eger application had been prepared by him as early as July 1, 1932, and the drawing of the application in this suit was shown to Mr. Watson on July 21, 1932, at this conference.

Ternes stated (App. p. 17) that Watson did not at that conference display any drawing of a valve where the spring was above or outside of the valve, nor did he display any drawing where the valve was conical.

Plaintiff's Exhibit 1 was offered by Watson himself as his Exhibit 5 in the interference No. 69,225 and there is nothing in this case which remotely indicates that it is not an accurate copy of the memorandum that was signed by Watson on July 21, 1932. On the contrary, Ternes testified (App. p. 17) that he was present at the conference and saw Mr. Watson sign the agreement and that the agreement was taken from the files of plaintiff and produced at the trial of the case.

He also testified (App. p. 19) that he had prepared the application of Eger, including the drawings, as early as July 1, 1932 (App. p. 19) and that a copy of the application drawing was attached to his affidavit under Rule 75, which is now a part of Plaintiff's Exhibit 4 (App. pp. 44-45).

From Ternes' testimony and from his affidavit which he reaffirmed at the trial it stands uncontradicted in this case that a draft of the Eger application as well as the drawings thereof and a model of the device shown in the drawings were all in existence as early as July 1, 1932, which not only preceded the meeting between Watson, Ternes, and Cadwell, but also preceded the filing date of the Watson patent relied upon by the defendant. This clearly carries Eger's date of invention back of the filing date of the Watson patent relied upon and, unless there is some kind of an estoppel against Eger arising out of the interference, it is submitted that the Watson patent should be disregarded as unavailable to the defendant as a reference in this case. It is submitted, therefore, that the trial court was clearly in error in concluding (App. p. 10 and Finding 8) that Watson was established as a prior inventor of all that is disclosed in the Watson patent and that Eger is not entitled to any claim which is not patentable over Watson.

It is plaintiff's contention that by the memorandum which Watson signed on July 21, 1932, he, in effect, disclaimed the two ideas which are stated in that memorandum to be Eger's, i.e., the conical valve and the placing of the valve spring on the outside of the valve. The Commissioner con-

tends that everything in the Watson patent is usable against Eger and that the disclaimer (Plaintiff's Exhibit 1) may be wholly disregarded. The defendant bases its contention upon the argument that some kind of an estoppel arose against Eger out of the interference between Eger and Watson. The defendant bases its argument upon three decisions by this Court, i.e., *Blackford v. Wilder*, 28 App. D. C. 535, 1907 C. D. 491; *In re. Wasserfallen*, 54 App. D. C. 367, 1924 C. D. 326, and *Daniels v. Coe*, 73 App. D. C. 54, 1940 C. D. 33. Our contention is that neither one of these cases supports the defendant's position.

We contend also that the present case is a recognized exception to the general rule stated in the above cases, the exception arising out of the facts stated in the agreement between Watson and Eger (Plaintiff's Exhibit 1, App. p. 86).

As a preliminary to the discussion of the legal questions, we call the Court's attention to the following facts:

It was admitted at the trial that the claims in suit could not have been counts of an interference between Watson and Eger because, even ignoring Plaintiff's Exhibit 1, Watson could not make the claims because they all call for a conical valve, which he does not show. In addition to the disclaimer, we submitted in the Patent Office several affidavits under Rule 75 carrying Eger's date of invention back of Watson's filing date and at no time did the Patent Office state that our showing on this point was insufficient. The position of the Examiner was as follows, as appears from the Examiner's statement (App. p. 64):

"The above points have been considered but it is the Examiner's opinion that since priority in the interference involving the present application and the application of the Watson patent 2,200,785 was awarded to Watson, the appellant cannot now overcome the Watson patent under Rule 75 or by Exhibit No. 5 of said interference.

It is therefore held that the Watson patent 2,200,785 is a good reference for all it discloses and may also

be combined with other art. The copending application of Watson patent 2,106,671 was introduced as evidence during the interference proceedings and is now available as art against the appellant."

We understand the defendant's position as expressed in the above quotation to be that the only reason why Eger could not antedate Watson was because priority in the interference was awarded to Watson. The defendant never took the position in the Patent Office that the affidavits under Rule 75 were insufficient to establish Eger's date as of July 1, 1932, but merely contended that we had no right under Rule 75 to antedate Watson because priority had been awarded to Watson in the interference.

In addition to the affidavits under Rule 75, Ternes testified as above pointed out and we believe his testimony, with the exhibits offered in connection therewith, clearly show it to be a fact that Eger's date of invention was at least as early as July 1, 1932. It is submitted that for the reasons which we shall now discuss, Eger is not estopped to antedate Watson because of the award of priority to Watson in the interference and that therefore the claims should be allowed over all of the objections of the defendant.

The Legal Question Involved.

Briefly stated, the sole legal question is whether Fig. 12 of the Watson patent No. 2,106,671 is available as a bar to the grant of Eger's claims. If the Watson patent may properly be used as a reference, then Eger is not entitled to the claims sought. If the Watson patent is not a proper reference, Eger is entitled to those claims.

There are two reasons why the Watson patent is not available as prior art. The first is that the structure such as that shown in Fig. 12 was not Watson's idea but was admittedly the invention of Eger. This is established by the agreement of July 21, 1932 (Plaintiff's Exhibit 1). The second is that Eger is shown to have invented the subject matter of the claims in issue at least as early as July 1, 1932, whereas the effective date of the Watson patent as a

reference is its filing date, namely, August 15, 1932. In view of the foregoing, Eger is clearly entitled to succeed unless there is some sort of bar in the nature of an estoppel arising out of the fact that he was in interference with Watson. It is the plaintiff's position that under the facts of this case there is no such estoppel.

There is no estoppel by judgment.

It is, of course, well established that the defeated party in an interference may not thereafter obtain claims *ex parte* which should have been adjudicated in the interference. This is the familiar case of *res judicata* or estoppel by judgment; it is the rule set forth and applied in the three cases on which the defendant relies. In all of those cases, claims which the applicants were seeking to obtain *ex parte* could and should have been introduced into earlier interferences, and the failure of the applicants so to introduce them debarred them from obtaining the claims after the termination of the interferences.

So far as *Blackford v. Wilder* and *In re Wasserfallen* are concerned, no further comment is necessary.

In *Daniels v. Coe*, the third case on which the defendant relies, Daniels had lost an interference to one Robie and in due course a patent issued to the latter. Daniels then sought to obtain two groups of additional claims, of which one group was refused on the ground of estoppel by judgment (it appearing that such claims could and should have been introduced into the interference). This is all there is in the case on the subject of estoppel. The claims of the other group sought by Daniels were such that they could *not* have been introduced into the interference, and these claims were refused not on the basis of estoppel but as unpatentable over Robie. Obviously had the estoppel theory been deemed applicable to the claims of this second group, they would have been readily disposed of on that ground but, instead, this Court carefully recognized the distinction and rejected on the ground of estoppel only those claims which could have been added to the prior interference.

With respect to the rejection of the other claims as unpatentable over Robie, it should be noted that the respective dates involved are not even mentioned, let alone discussed, and (barring an oversight) it must be assumed that Robie's effective date was in fact early enough to constitute his patent a valid reference against Daniels.

In the case at bar the rule of estoppel by judgment applied in the above three cases has no application whatsoever for the reason (conceded by the defendant at the trial) that the claims now sought by Eger could *not* have been adjudicated in his interference with Watson. The claims in issue set forth combinations including a conical valve, and all agree that Watson's disclosure could not have supported any such claims. There is not and cannot be any estoppel by judgment where, as here, the claims involved could not have been made the subject of the earlier interference. *International Cellucotton Products Co. v. Coe*, 66 App. D. C. 248, 85 Fed. (2d) 869; *American Cyanamid Co., et al. v. Coe*, 70 App. D. C. 330, 106 Fed. (2d) 851; *Tinnerman Products, Inc., et al. v. Coe*, 50 Fed. Supp. 337, decided June 9, 1943, by Mr. Justice Lohring.

It is manifest, therefore, that in so far as it is based on the principle of estoppel by judgment the defendant's contention must fail.

There is no other estoppel.

It cannot be emphasized too strongly that the effective date of the Watson patent on which the defendant relies is too late to permit that patent to be used as a valid reference, unless there is some compelling estoppel requiring the Court to close its eyes to the facts.

It is clear beyond question, we believe, that since there is no estoppel by judgment the defendant's contention must find support, if at all, in some form of equitable estoppel. But on that score, also, we submit, the defendant's position is likewise untenable. In the first place, this Court has definitely rejected the notion that there is any estoppel *in pais* operating in cases of this general character. The question

of whether such an estoppel is by judgment or *in pais*, was discussed at length by this Court in *International Cellucotton Products Co. v. Coe*, 66 App. D. C. 248, 85 Fed. (2d) 869; and it was affirmatively held that such estoppels as do operate in these cases are estoppels by judgment and not *in pais*. This ruling was reaffirmed and reiterated by this Court in *American Cyanamid Co., et al. v. Coe*, 70 App. D. C. 330, 106 Fed. (2d) 851.

Furthermore, estoppels do not operate blindly but for cause and when clearly required.

As stated by the Court of Customs and Patent Appeals in *In re Long*, 83 Fed. (2d) 458, 463, 464:

“... The so-called bar or estoppel applied by the Patent Office, to have any basis in law whatever, must rest upon the fact that to otherwise hold would be visiting an injustice upon some one, and that the injustice arose from the conduct of the appellant. . . . It is too well settled to require extended citation of authority that estoppels, and bars not created by statute, when interposed against statutory rights, are not favored by the courts. They should never be applied except where the facts upon which such doctrines are based are clear and definite and never on suppositious, conjectural or hypothetical premises.”

In the present case we are completely at a loss to find any basis for an estoppel. The need to put an end to or prevent the recurrence of litigation is of course the common reason for the rule *res judicata*, but clearly it has no application here. Since Watson (as conceded by the defendant) cannot make the claims which Eger seeks there can be no new interference declared. Indeed, we fail to see how any unfairness or injury to Watson, or to the public at large, can result from the allowance of Eger's claims.

Plaintiff is entitled to the claims in suit.

The facts of the *Long* case, above cited, are strikingly similar to those of the case at bar, and can only lead, we believe, to a like result.

In the *Long* case, the appellant Long had been defeated in a three party interference with Evans and Day. After the interference and in the further *ex parte* prosecution of his application, Long was denied certain claims by the Examiner and the Board of Appeals on the ground that such claims could and should have been advanced in the interference; and that, having lost the interference, Long was estopped to obtain such claims *ex parte*. It appeared that the claims sought by Long could in fact have been advanced in the interference; that is to say, so far as their disclosures were concerned both Day and Evans could have made the claims in question. However, both Evans and Day had made certain statements (in the case of Evans in his application, and in the case of Day in amendments and arguments appearing in his application file), from which the Court of Customs and Patent Appeals felt warranted in reaching the conclusion that both parties had acknowledged that they were not the inventors of the subject matter of the claims Long later sought to obtain. In these circumstances the Court reversed the Board and held that there was nothing inequitable in the granting of such claims to Long, rather that it would be inequitable to deny them; and that there was no estoppel because no basis for it could be found. Since neither Evans nor Day was in a position to claim inventorship of the subject matter it would have been futile for Long to try and introduce his claims into the interference; and his failure to do so, being fair and reasonable, could not give rise to any estoppel. It should also be noted that the Court reached these conclusions notwithstanding the fact that the claims before it and which it allowed to Long, *were actually broader* than the claims which had been the subject of the three party interference.

The case at bar is far stronger for the allowance of the Eger claims even than it was for the allowance of Long's claims. Eger's claims are not broader than any previously adjudicated but are directed to a particular species of the invention. Watson, unlike Evans and Day, could not even

have made the claims here in issue, because his disclosure would not support them. Furthermore, Eger's position, unlike that of Long, does not depend upon negative inferences and conclusions from arguments and the like in the application file, but is established beyond question by Watson's own signed statement that the subject matter of the claims now sought by Eger was in fact Eger's invention (Plaintiff's Exhibit 1).

As in the *Long* case, so here: the defeated party to the interference knew that the successful party would be unable to make any claim of inventorship of the subject matter of the later *ex parte* claims and that it would have been a futile gesture to advance them in the interference; and, we submit there is likewise no basis whatsoever in the case at bar for any estoppel.

Another case in support of plaintiff's contention is that of *In re Thomas*, 8 U. S. P. Q. 90, by the Board of Appeals of the Patent Office. In that case, there had been an interference between Thomas and two other parties. After the interference had terminated, Thomas presented some claims which *could have been made* by one of the parties to the interference and the Examiner rejected the claims on the familiar ground of estoppel, claiming that Thomas should have presented them under Rule 109 in the interference.

Thomas took an appeal to the Board of Appeals in the Patent Office and prior to the date of the hearing had secured from one of his opponents (Stahl) in the interference a concession of priority of the claims on appeal. This paper was submitted at the hearing and the Board stated (p. 92):

"In view of this concession it is not seen that Stahl can now be assumed to be injured by the conduct of Thomas and subsequently there is no estoppel. Obviously, with only one party claiming given subject matter there is no question of another interference and therefore no reason for insisting on the estoppel, the main purpose of the rule being to prevent successive interferences".

In the present case, the agreement of July 21, 1932 (Plaintiff's Exhibit 1) is the full equivalent of the concession by Stahl, particularly when this is coupled with the admitted fact that the claims in suit could not have been made by Watson. The situation here then becomes strikingly similar to that in *In re Thomas* because, in view of the agreement, Watson cannot now be assumed to be injured by the conduct of Eger and consequently there is no estoppel. Only one party is claiming the subject matter and admittedly there could not be another interference on this subject matter and therefore there is "no reason for insisting on the estoppel, the main purpose of the rule being to prevent successive interferences".

We have shown by the testimony of Ternes that as early as July 1, 1932, a draft of the Eger specification had been prepared, that drawings of the Eger construction had also been made, and that a model of the Eger device had been constructed (App. p. 19). This showing is entirely sufficient to carry Eger's date of invention back of the filing date of Watson and would be sufficient in and of itself to render the Watson patent unavailable.

All that is required is to show a completion of the invention and that is clearly proven here by the testimony of Ternes to the effect that not only drawings identical with those in the Eger application, but a draft of the application as well as an actual model of the device shown in the drawings were all in existence as early as July 1, 1932 (Plaintiff's Exhibit 4).

Walker on Patents, Deller 1937 Edition, page 298, states:

"In cases where a patented invention is explained in words, without the aid of any model or any drawing, it will date from the completion of such a written description as would teach others how to make and use the invention described. In cases where the inventor makes a specimen of the thing invented, before he makes any model, or drawing, or written description to represent that thing, the invention will date from the completion of that specimen. Perfection is not

necessary to such a specimen in order to entitle it to such an effect. Substantial completeness is enough. [*National Cash Register Co. v. Store Service Co.*, 60 Fed. 603, C. C., D. N. J. (1894); *Coffee v. Guerrant*, 68 O. G. 279 (1894); *Conway v. White*, 9 F. (2d) 863, 868, C. C. A. 2.]”

We call the Court's attention to the notice of allowance (App. p. 42) of the claims here in suit which clearly proves that the Examiner was of the opinion that these exact claims are patentable over the disclosures of the patents to Knight, Sahuc, and the French patent. The testimony of Ternes (App. pp. 20 to 26) points out the distinctions and advantages of the claims in suit over these three patents and it was our understanding at the trial that the Court agreed (App. p. 26) that the claims are patentable over these three prior patents.

Having, we believe, conclusively shown that the Watson patent is not available and that the claims are patentable over the other three patents cited by the Patent Office, it is respectfully submitted that the claims are patentable and that the prayer of the complaint should be granted.

Respectfully submitted,

GIFFORD, SCULL & BURGESS,
Attorneys for Plaintiff-Appellant.

NEWTON A. BURGESS,
LESTER G. BUDLONG,
RALPH B. STEWART,
Of Counsel.

STATUTES INVOLVED.

SEC. 4915. (U. S. C., title 35, sec. 63.) Whenever a patent on application is refused by the Board of Appeals or whenever any applicant is dissatisfied with the decision of the board of interference examiners, the applicant, unless appeal has been taken to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided, in which case no action may be brought under this section, may have remedy by bill in equity, if filed within six months after such refusal or decision; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law. In all cases where there is no opposing party a copy of the bill shall be served on the commissioner; and all the expenses of the proceedings shall be paid by the applicant, whether the final decision is in his favor or not. In all suits brought hereunder where there are adverse parties the record in the Patent Office shall be admitted in whole or in part, on motion of either party, subject to such terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court may impose, without prejudice, however, to the right of the parties to take further testimony. The testimony and exhibits, or parts thereof, of the record in the Patent Office when admitted shall have the same force and effect as if originally taken and produced in the suit.

4-5

APPENDIX

6-53

INDEX TO JOINT APPENDIX.

	Page
Pleadings, Docket Entries and Other Papers Designated:	
Bill of Complaint	2
Answer	7
Findings of Fact	9
Conclusions of Law	10
Judgment	10
Notice of Appeal	11
Testimony by Appellants	11
Raymond F. Ternes	11
Appellant's Exhibits	31
No. 1, Cadwell Memorandum	31
No. 2, Drawing of Valve Structures	33
No. 3, Drawing of Valve Structures	34
No. 4, Certified Papers from Eger Application....	35
Ternes Affidavit, Rule 75	44
Eger Affidavit, Rule 75	53
Blackie Affidavit, Rule 75	57
Excerpts from Defendant's Exhibit 1	59
Examiner's Statement on appeal	59
Decision of Board of Appeals	65
Translation of French Patent 543,850	71
Knight Patent 1,471,172	75
Sahuc Patent 1,475,554	77
Watson Patent 2,106,671	80
Watson Patent 2,200,785	89

IN THE
United States Court of Appeals

DISTRICT OF COLUMBIA.

No. 8710.

UNITED STATES RUBBER COMPANY, a Corporation
organized under the laws of the State of New Jersey,
Appellant,

v.

CONWAY P. COE, Commissioner of Patents and/or his
successor in office, *Appellee.*

Appeal from the District Court of the United States for the
District of Columbia.

JOINT APPENDIX.

I.

**PLEADINGS, DOCKET ENTRIES AND OTHER
PAPERS DESIGNATED.**

1

Filed July 22 1942

Complaint for the Issuance of Letters Patent

The Plaintiff by its Complaint, alleges as follows:

1. This action arises under the patent laws of the United States under U. S. Code Title 35, Sec. 63 (Rev. Stat. Sec. 4915).

2. Plaintiff, United States Rubber Company, is a corporation organized under the laws of the State of New Jersey and having offices at 1230 Sixth Avenue in the City of New York, County of New York and State of New York.

3. Defendant, Conway P. Coe, is the Commissioner of Patents of the United States and as such is an inhabitant of the District of Columbia.

4. That heretofore and prior to the 28th day of September 1932 Ernst Eger was the original, first and sole inventor of a certain new and useful improvement in Valve Mechanisms which was not known or used by others
2 in this country before his invention or discovery thereof and not patented or described in any printed publication in this or any foreign country before his invention or discovery thereof or more than two years prior to September 28th, 1932; that said invention was not in public use or on sale in this country for more than two years prior to the filing date of the application hereinafter referred to and was not previously patented or caused to be patented by said inventor or his legal representatives in any foreign country on an application filed more than twelve months prior to his said application in this country and that said invention has not been abandoned.

5. That Ernst Eger being the original, first and sole inventor of said improvement did on September 28th, 1932 make application in due form of law to the United States

Commissioner of Patents, in accordance with the provisions of the then existing laws of the United States in such cases made and provided, for the issuance of Letters Patent of the United States to him for his said invention, which application was given Serial No. 635,209 and in respect thereto complied with all the conditions and requirements of said laws of the United States and of the rules of practice of the United States Patent Office in such cases made and provided.

6. That by an instrument in writing dated September 20, 1932 and duly recorded in the Transfers of Patents in the United States Patent Office in Liber E-154, Page 455, said Ernst Eger assigned to Morgan & Wright, a corporation organized under the laws of the State of Michigan, his entire right, title and interest in and to the invention covered by said application Serial No. 635,209 and all rights and privileges under any and all Letters Patent that may be granted therefor.

7. That by an instrument in writing dated February 8, 1935 and duly recorded in the Transfers of Patents in the United States Patent Office in Liber F-162, Page 604, said Morgan & Wright assigned to the plaintiff, United States Rubber Company, the entire right, title and interest in and to the said inventions covered by said application Serial No. 635,209 and all rights and privileges under any and all Letters Patent that may be granted therefor.

8. That said application has been examined by the Primary Examiner of the United States Patent Office, who refused to allow the following claims which he finally rejected in accordance with the rules of practice of the United States Patent Office.

Claim 24. A valve stem comprising a molded body of flexible material having base and tip portions and an axial air passage extending therethrough from the base to the tip portions, said body having a restricted portion sloping inwardly of the passage and toward the tip portion providing an inwardly tapering surface forming a valve seat, a

valve element disposed in the passage and having a conical surface for engaging the tapering body surface, metallic means associated with the stem exteriorly of the body seat and serving as a reenforcement for said seat, a pin carried by the valve element and extending longitudinally of the passage toward the stem tip, and a metallic spring associated with said pin and disposed within and operatively supported by said metallic means for urging the valve element to its closed position to cause passage sealing engagement between said tapering and conical surfaces.

4 Claim 25. A valve stem comprising a molded body of flexible rubber composition having base and tip portions and an axial air passage extending therethrough from the base to the tip portions, said body having a restricted portion sloping inwardly of the passage and toward the tip portion providing an inwardly tapering surface forming a valve seat, a valve element disposed in the passage and having a conical surface for engaging the tapering body surface, metallic means associated with the stem exteriorly of the body seat and serving as a reenforcement for said seat, a pin carried by the valve element and extending longitudinally of the passage toward the stem tip, and a metallic spring associated with said pin and disposed within and operatively supported by said metallic means for urging the valve element to its closed position to cause passage sealing engagement between said tapering and conical surfaces.

Claim 26. A valve stem comprising a molded body of flexible material having base and tip portions and an axial air passage extending therethrough from the base to the tip portions, said body having a restricted portion sloping inwardly of the passage and toward the tip portion providing an inwardly tapering surface forming a valve seat, a valve element disposed in the passage and having a conical surface for engaging the tapering body surface, metallic means associated with the stem exteriorly of the body seat and serving as a reenforcement for said seat, a pin carried

by the valve element and extending longitudinally of the passage toward the stem tip, and a metallic spring enclosing said pin and disposed within and operatively supported by said metallic means for urging the valve element to its closed position to cause passage sealing engagement between said tapering and conical surfaces.

Claim 27. A valve stem comprising a molded body of flexible material having base and tip portions and an axial air passage extending therethrough from the base to the tip portions, said body having a restricted portion sloping inwardly of the passage and toward the tip portion providing an inwardly tapering surface forming a valve seat, a valve element disposed in the passage and having a conical surface for engaging the tapering body surface, metallic means associated with the stem exteriorly of the body seat and serving as a reenforcement for said seat, a pin carried by the valve element and extending longitudinally of the passage toward the stem tip, a metallic spring enclosing said pin and disposed within and operatively supported by said metallic means for urging the valve element to its closed position to cause passage sealing engagement between said tapering and conical surfaces, and a spring seat carried by the pin for imparting longitudinal movement thereto.

5 Claim 28. A valve stem comprising a molded body of flexible material having base and tip portions and an axial air passage extending therethrough from the base to the tip portions, said body having a restricted portion sloping inwardly of the passage and toward the tip portion providing an inwardly tapering surface forming a valve seat, a valve element disposed in the passage and having a conical surface for engaging the tapering body surface, metallic means associated with the stem exteriorly of the body seat and serving as a reenforcement for said seat, a pin carried by the valve element and extending longitudinally of the passage toward the stem tip, a metallic spring enclosing said pin above said valve element and dis-

posed within and operatively supported by said metallic means for urging the valve element to its closed position to cause passage sealing engagement between said tapering and conical surfaces, and a spring seat carried by the pin for imparting longitudinal movement thereto.

9. After the aforesaid final rejection of said application by the Primary Examiner, an appeal was taken, pursuant to law, from the aforesaid rejection to the Board of Appeals of the Patent Office and said Board of Appeals affirmed said final rejection of the Primary Examiner in their decision dated February 27th, 1942 and that no appeal from said decision has been taken to the Court of Customs and Patent Appeals.

10. That the decisions of the Primary Examiner and of the Board of Appeals constitute a refusal of the Commissioner of Patents to grant a patent on said application embodying said claims.

11. Notwithstanding the said decisions of the Primary Examiner and of the Board of Appeals, and having exhausted all remedy of appeal in the Patent Office in the matter attempting to obtain a patent on the aforesaid claims on said application Serial No. 635,209 and the inventions covered thereby, plaintiff hereby avers, on information and belief, that it has by virtue of the United States Statutes in such cases made and provided, a remedy by an action in this Court compelling and authorizing the grant of a patent on said application for the inventions covered by said claims, and that the plaintiff, United States Rubber Company, is entitled to receive a patent upon said application and the inventions covered thereby embodying the aforesaid claims included in said application before the Commissioner of Patents.

Wherefore, plaintiff prays a Judgment and Decree of this Court that Ernst Eger was the original, first and sole inventor of said improvement in Valve Mechanisms described in said application Serial No. 635,209 and claimed in said claims 24, 25, 26, 27 and 28, and that plaintiff, United

States Rubber Company, is entitled, according to law, to receive a patent for said inventions as described in said application and claimed in said claims and authorizing and directing the Commissioner of Patents to grant and issue a patent to plaintiff, United States Rubber Company, upon the aforesaid application and the aforesaid claims upon the filing in the Patent Office of the Judgment and Decree of this Court and upon compliance with the requirements of law in such cases made and provided.

UNITED STATES RUBBER COMPANY

By ELMER STEWART

Attorney for Plaintiff

National Press Building

Washington, D. C.

NEWTON A. BURGESS

141 Broadway, New York City

LESTER G. BUDLONG

1230 Sixth Ave., New York City.

NEWTON A. BURGESS

LESTER G. BUDLONG

Of Counsel

* * * * *

7

Filed Aug 6 1942

Answer to the Complainant

To the Honorable the Justices of the District Court of the United States for the District of Columbia

1, 2, 3, 4, 5, 6, 7, 8, 9, 10. Defendant admits the allegations of paragraphs 1, 2, 3, 4, 5, 6, 7, 8, 9 and 10.

11. He admits that plaintiff has exhausted all remedy of appeal in the Patent Office in the matter of attempting to obtain a patent containing claims 24, 25, 26, 27 and 28 of application, No. 635,209, of Ernst Eger, entitled Valve Mechanisms. He denies that under the applicable United States Statutes, plaintiff has a remedy by an action in this

Court to compel the grant of a patent including said claims. He admits that under the applicable Statute, Section 4915 R. S. (U S C Title 35, Sec. 63) the adjudication if it be in favor the plaintiff shall authorize the Commissioner to issue such patent on compliance by plaintiff with certain requirements. He denies that plaintiff is lawfully entitled to receive a patent on said application of Ernst Eger, containing any of claims 24, 25, 26, 27 and 28 thereof, as it is deemed that said claims are unpatentable in view of the following prior patents, and for the reasons given by the Examiner in his Statement on the appeal and in the decision of the Board of Appeals, copies of which will be furnished to the Court at the trial:

French patent	543,850	June 10, 1922
Knight	1,471,172	Oct. 16, 1923
Sahuc	1,475,554	Nov. 27, 1923
Watson	2,106,671	Jan. 25, 1938
Watson	2,200,785	May 14, 1940

Profert of copies of the above-identified patents is hereby made.

W. W. COCHRAN

Solicitor, United States Patent Office

Washington, D. C.

Attorney for Defendant

August 4, 1942

I hereby certify that a copy of this Answer to the Complaint was mailed today, August 4, 1942, to the attorney for plaintiff, Elmer Stewart, National Press Building, Washington, D. C.

W. W. COCHRAN

Solicitor

* * * * *

Filed Dec 2 1943

Findings of Fact

1. This is an action under R. S. 4915 (U. S. C., title 35, sec. 63) in which it is sought to have the Court find that the plaintiff United States Rubber Company, as assignee of the application of Ernst Eger, No. 635,209, is entitled to have issued to it a patent containing claims 24 to 28, inclusive, of the said application.

2. The Eger application here involved discloses a rubber valve stem member comprising a tapered seat which is engaged by a conical valve. This valve has a stem which extends through the open end of the rubber valve stem and which is supported in a metal member which embraces and reinforces the upper end of the said rubber stem. The valve is urged into closed position by a spring mounted in the metal member.

3. Each of the patents to Watson No. 2,106,671 and 2,200,785 discloses a valve structure which is substantially identical with that of Eger, except that Watson
10 employs a spherical valve, while Eger uses a conical one.

4. Each of the patents to Knight 1,471,172, Sahuc 1,475,554 and French patent 543,850 discloses a tire valve construction embodying a conical valve member. In Knight, this member is urged toward seating position by a spring located above the valve.

5. Each of the claims here involved is readable on the disclosure of either of the patents to Watson 2,106,671 and 2,200,785, except that the claims call for a conical valve member, whereas Watson shows a spherical one.

6. It would not require invention over the patents to Knight and Sahuc and the French patent 543,850 to replace Watson's spherical valve by a conical valve.

7. The claims set forth in the complaint define nothing patentable over the disclosure of either of the Watson patents.

8. The plaintiff has failed to establish a reduction to practice of the invention set forth in the claims here involved prior to August 15, 1932, the filing date of the application on which Watson patent 2,106,671 was issued, or to establish conception prior to that date coupled with diligence in reducing the invention to practice.

9. The Eger application included in this action was involved in an interference with the application on which Watson patent 2,200,785 was granted and in the said interference priority of invention was finally awarded
11 to Watson.

Conclusions of Law

1. The effect of the award of priority in the interference between Watson and Eger was to establish conclusively that Watson was the prior inventor of all subject matter common to the interfering applications.

2. Since Watson is thus established as the prior inventor of such subject matter, Eger is not entitled to any claim which is not patentable over such subject matter.

3. Plaintiff is not entitled to a patent containing any of the claims set forth in the complaint.

4. The complaint should be dismissed as to all claims involved.

Enter December 2, 1943.

ELMER D. DAVIES

Justice.

* * * * *

12

Filed Dec 2 1943

Judgment

This action came on to be heard at this term and thereupon, upon consideration thereof, it is

Adjudged that the complaint in this case be, and the same hereby is dismissed with costs against the plaintiff.

Enter December 2, 1943.

ELMER D. DAVIES

Justice.

* * * * *

13

Filed Dec 31 1943

Notice of Appeal

Notice is hereby given that United States Rubber Company, the above named plaintiff, hereby appeals to the United States Court of Appeals for the District of Columbia from the final judgment entered in this action on the 2nd day of December 1943.

RALPH B. STEWART

Attorney for Appellant United States Rubber Co.

National Press Building
Washington 4, D. C.

December 31, 1943

* * * * *

II.

TESTIMONY.

37 **Raymond F. Ternes** a witness on behalf of the plaintiff, was first duly sworn by the Deputy Clerk and was then examined and testified as follows:

Direct Examination

By Mr. Burgess:

Q. 1. What is your employment, Mr. Ternes? A. I am with the United States Rubber Company.

Q. 2. How long have you been with them? A. Approximately 21 years.

Q. 3. And state briefly what your experience has been during that period. A. During that period I was employed first as a machine designer in the engineering department of the company for three or four years; and at the
38 end of that period I became associated with the patent work; and I carried on that work for the balance of the twenty-one years of my service with the company. All of this work developed gradually from the engineering end into the patent end.

Q. 4. At which plant of the United States Rubber Company have you been located? A. At the Detroit plant.

Q. 5. And is that plant devoted principally to the making of automobile tires? A. Substantially all of the work at the Detroit plant is devoted to tires.

Q. 6. What has been your experience in the designing and manufacturing of tires and tire equipment? A. Again, substantially all of my experience has been connected directly with tires and tire equipment.

Q. 7. Have you, as a result of your experience, had occasion to come in contact with the practical end of the tire making and servicing business. A. Yes. My work in connection with the development division has followed through, from the conception of new ideas, to the time when the new ideas are taken over by the sales division.

Q. 8. And, specifically, have your duties brought you into contact with the making or the designing of valve stems for tires, such as the subject we have here today? A. Yes; it has.

Q. 9. With what other plants of the Company, if any, do you have contact? A. I have contact with the Indianapolis plant, the Eau Claire, Wisconsin, plant
39 and the Los Angeles, California, plant.

Q. 10. Where are the valve stems made by the United States Rubber Company, at which plant? A. They are principally made at the Indianapolis plant.

Q. 11. What has been your relationship to the development department at Indianapolis? A. The development department in Indianapolis is under the control of the Detroit Development Department and I am in direct contact with development work at both the Detroit and the Indianapolis plants.

Q. 12. Would you state whether or not your contact with the Indianapolis Development Department has been rather intimate or close? A. Yes; it has been.

Q. 13. Now, will you state some of the problems involved in the design and manufacture of a valve stem such as the

one which has become the subject matter of this suit? A. A valve stem must be acceptable to the automotive industry; and a valve stem of this general character requires extensive testing; that is, it must be tested over a period of years in order to assure that it will withstand the abuse to which it is subjected. It must be compounded in such a manner that it will not deteriorate with age, because the aging of the rubber is a vital factor. There is—

By the Court:

Q. 14. (interposing) Does the fact that that is a rubber valve stem make any difference at all in this? A. Yes; it does.

40 The Court: In what way? It seems to me that the patent is as to this stem. I mean this core in the valve stem itself.

Mr. Burgess: Well, you see, if the Court please, the arrangement of the stem itself is surely a part of it, because the claims call for the seat being a part of the body of the valve.

The Court: I know. But this seat (indicating) is seated on the valve.

Mr. Burgess: No, sir.

The Court: It looks like to me it is.

Mr. Burgess: No, sir.

We have here in the claim this language:

“said body having a restricted portion sloping inwardly of the passage and toward the tip portion providing an inwardly tapering surface forming a valve seat * * *”.

The valve seat is an integral part of the rubber stem; and it is formed by this restriction of the passageway, which you will see in the drawing, there, of the application. You will see that the rubber forms the valve seat.

The Court: This (indicating)?

Mr. Burgess: Yes. That is the same thing.

The Court: This (indicating) is the seat, here, this thing here?

Mr. Burgess: No, sir; that is not the seat. The seat is down below.

If I may come to the bench, perhaps I could help the Court.

By looking at this drawing, you see a seat here (indicating) in the rubber; and the conical valve comes down
41 against that seat and contacts with the rubber to seal it. The spring pushes this (indicating) up against this (indicating), so that it seats normally.

The Court: This (indicating) is what keeps the air from getting out; and the spring is up here (indicating)?

Mr. Burgess: That is right.

The Court: That (indicating) is the seat; and when it is seated here (indicating) it is closed?

Mr. Burgess: Yes, sir; here (indicating).

The Court: Against this metal (indicating)?

Mr. Burgess: No, sir; it is not seated against the metal.

The Court: When the air forces this (indicating) up and it comes down here (indicating), why isn't it seated against this (indicating)?

Mr. Burgess: It is not because it is held against this rubber seat down here (indicating); and it is held away from the valve, you see.

The Court: This (indicating)?

Mr. Burgess: The seat is down here (indicating).

The Court: Well, I have always been taught that a valve seat is where the valve hit, right down close against the container, and kept the thing from going through it.

Mr. Burgess: You are right. But in this valve the seat is down where this metal conical valve strikes the rubber.

The Court: It shows more on the drawing than it does on the actual valve itself.

Mr. Burgess: That is because this thing, here (indicating), is down this way (indicating). Now, that is the way the valve normally operates; but it is not seated.

42 The valve is down there (indicating).

The Court: You say it is seated here (indicating)?

Mr. Burgess: Yes.

The Court: When you push this plunger down the valve is open; and the air will come out?

Mr. Burgess: That is true only if you push it off its seat, here (indicating).

The Court: Well, it does not appear that way in this.

Mr. Burgess: Well, it is an important feature here that the seat is right there at the point indicated by the numeral 13 in this drawing, where this metal conical valve strikes the rubber, that is brought in at this restriction; and that is the way it is described in the specification and that is the way it is shown in the drawing. That valve is seated as shown in that Fig. 2 of the drawing, right there. The sealing is brought about by the metal conical valve 16 striking the rubber seat which is integral with the rubber body of the stem.

You can not see it very well from that sample, your Honor. It is a bad sample; and it merely shows what the general relationship is.

The Court: That (indicating), though, is practically the same thing.

Mr. Burgess: It is the same, oh, yes, as the Watson Fig. 12. That is true enough, as Mr. Reynolds says. Our point is that that is not available to the Patent Office as a reference.

The Court: It seems to me like that is the only question in this law suit, because this agreement itself recognizes that there is no difference between these two valves
43 except in the fact that Mr. Eger has the spring above the sealing member and Mr. Watson proposes to put his below; furthermore, that the Watson metal valve is spherical, whereas Mr. Eger's is conical; and I don't think that makes a bit of difference in the world; and, furthermore, that Mr. Eger has a screwed on cap instead of a rubber one, which I don't think is very important.

So it seems to me that the only difference is just exactly what is set out in this agreement.

Mr. Burgess: That is the only difference.

The Court: That is the only question in this law suit, isn't it?

Mr. Burgess: The only question here, as I see it, is whether or not the Patent Office is in a position to cite the Watson patents against us.

The Court: Let us try that question.

Mr. Burgess: That, I think, is a legal question.

The Court: If they are not in a position to do that, I do not think they are in a position to deny the patent.

Mr. Burgess: I agree with your Honor.

The Court: Let us try that question and it will save a lot of time.

Mr. Burgess: That, your Honor, involves more than a matter of argument; it is a matter of evidence.

The Court: He has objected to the introduction of this agreement.

Mr. Burgess: All right. But I did not understand that Mr. Reynolds' objection—

The Court (interposing): He is objecting to it
44 on two grounds: First, that it is hearsay; and, second, that the question can not be determined in a proceeding of this kind.

By Mr. Burgess:

Q. 15. I show you an agreement. Do you recognize that?

A. Yes; I do.

Q. 16. Does your name appear upon that paper? A. Yes; it does. I attended that meeting.

Q. 17. You say you were present at the time the meeting was had of which this is a memorandum? A. I was; and this memorandum was dictated in the presence of all the parties at that time.

Q. 18. And in your presence? A. Yes.

Q. 19. Where did you get that paper to bring it here today? A. From our own files at Detroit.

Q. 20. And, so far as you know, it has been in those files ever since the date it bears? A. Yes; it has.

Q. 21. Do you recognize the signature of Dr. Sidney M. Cadwell? A. I do.

Q. 22. He was present at that meeting, too? A. He was.

Q. 23. Would you say whether or not the agreement was signed in your presence by the parties? A. It was signed in my presence.

Q. 24. And you saw Mr. Watson sign it? A. I did.

Mr. Burgess: If the Court please, I offer the document in evidence.

Mr. Reynolds: I still object to it, as immaterial.

* * * * *

53 The Court: You had just introduced this exhibit.

Mr. Burgess: That will be plaintiff's Exhibit 1.

(The document had heretofore been admitted, subject to objection, and marked as Plaintiff's Exhibit 1, as appears hereinbefore.)

By Mr. Burgess:

Q. 25. Mr. Ternes, you have said you were present at this meeting of July 21, 1932? A. Yes.

Q. 26. Did Mr. Watson disclose at that meeting any valve stem with a spring on the outside? A. No; he did not. He disclosed some valve stems with the springs on the inside.

Q. 27. Now, there is a drawing, referred to in this Plaintiff's Exhibit 1, the drawing being stated to be dated May 28, 1931, and witnessed by Messrs. F. E. Goodwin, E. L. Dean and James L. Hearne.

I show you a drawing and ask you if you recognize
54 that drawing? A. Yes; that is the drawing that was submitted at that meeting.

Q. 28. Show it to the Court, please. A. Yes, sir (exhibiting a blue print drawing to the Court).

Q. 29. And is there any valve stem shown on that drawing with the spring on top or showing a conical valve? A. No; there is not.

Mr. Burgess: If the Court please, I offer that as Plaintiff's Exhibit 2, being explanatory of Plaintiff's Exhibit 1, which refers to a drawing.

The Court: All three drawings?

Mr. Burgess: I think those are just copies. The blueprint is the one that I am offering in evidence.

The Court: All right. Submit it to defendant's counsel.

Mr. Reynolds: I do not believe this has been sufficiently identified here. I am not sure what the witness had to do with this drawing.

The Court: He just said that it was exhibited at this conference.

Mr. Reynolds: In July, 1932?

By Mr. Burgess:

Q. 30. You saw that drawing at that time, did you? A. That is correct.

The Court: It is admitted.

(The blueprint drawing so produced and identified was received in evidence and marked as Plaintiff's Exhibit 2.)

55 By Mr. Burgess:

Q. 31. I show you another drawing and ask if you will identify that drawing? A. This is a drawing of a valve stem made a few days after our meeting with Mr. Watson.

Q. 32. Who made that drawing? A. I did.

Q. 33. What date does it bear? A. It is dated July 29, 1932.

Q. 34. And what was supposed to be represented by this drawing of July 29, 1932? A. This was my recollection of the type of stem submitted by Mr. Watson.

Mr. Burgess: I offer this drawing in evidence as Plaintiff's Exhibit 3.

Mr. Reynolds: I would just like to make a continuing objection to all of this evidence.

The Court: I will sustain the objection to that. I do not see that it is material what that shows.

(The drawing so produced and identified was marked as Plaintiff's Exhibit 3 for identification.)

By Mr. Burgess:

Q. 35. Mr. Ternes, you made an affidavit that was filed in the Eger application; and I have a certified copy of it which I will show you. Will you state whether or not you identify that affidavit? A. Yes; this is an affidavit which I made in that matter.

Q. 36. And in that affidavit you refer to the preparation of a draft of the Eger application here in suit, and attach a copy to your affidavit? A. Yes.

Q. 37. What is the date of the draft of the specification which I show you? A. The date of that draft is July 1st, 1932.

Q. 38. State whether or not you prepared that draft at that time? A. I did prepare the draft.

Q. 39. On what day? A. On July 1st, 1932.

Q. 40. And attached to this affidavit also is a drawing. Will you please state what that drawing is? A. The drawing is a disclosure of the Eger valve.

Q. 41. Is it the same drawing as that of the application in suit? A. The same as the drawing of the application in suit; and it was made prior to the date of the description of July 1st, 1932.

Q. 42. State whether or not you saw one of the Eger valves prior to July 1st, 1932. A. I did.

Q. 43. And was that valve of the same or a different construction from that shown in this drawing attached to your affidavit? A. It was identical with that construction.

Mr. Burgess: If the Court please, there are also affidavits in this set of certified copies I have here, made by Mr. Eger and by William M. Blackie, all corroborating this testimony just given.

The paper that I hold in my hand consists of certified copies of the application in this suit, with the drawings attached; and, also, certified copies of the affidavits mentioned, which were filed under Rule 75 of the Patent Office, including the one that Mr. Ternes has just identified; and I offer all those as Plaintiff's Exhibit 4.

Mr. Reynolds: If those affidavits are offered as proof of what Mr. Ternes has said, I object to them.

Mr. Burgess: Mr. Ternes has identified and has stated here the substance of his affidavit, namely, that he prepared on July 1st, 1932, the draft of this application of Ernst Eger (which is attached) and it speaks for itself; and there was a drawing attached, which is identical with the drawing of the application here, all of which shows clearly that the structure of the Eger application and a drawing of that structure were in existence prior to the time of this meeting with Mr. Watson and, in fact, prior to July 1st, 1932. That is certainly in evidence by the testimony of Mr. Ternes.

The Court: I sustain the objection as to as to the affidavits.

Mr. Burgess: Which affidavits?

The Court: The affidavits that you offer.

Mr. Burgess: Of Mr. Eger and Mr. Blackie?

Mr. Reynolds: Those are the only ones I object to.

The Court: He is not objecting to those others.

Mr. Burgess: I want to make that clear; they are all bound together in this certification.

Mr. Reynolds: I have no objection to their being received as showing that they were filed. I just object to them
58 as tending to prove what they say; that is all.

The Court: Very well.

(The certified copies of documents so produced and identified were received in evidence and marked as Plaintiff's Exhibit 4.)

By Mr. Burgess:

Q. 44. Mr. Ternes, will you please discuss the patents that have been cited by the Examiner in this case or set up in the answer of the defendant here as prior art against the claims in this suit, starting in with the first, the patent to Knight, 1,481,172. Do you have copies of them with you?

A. The patent to Knight shows an all-metal valve construc-

tion, and the entire valve body and the conical member are both metal.

This type of valve mechanism we usually refer to as an adapter, that is, it does not comprise the principal valve embodiment. It is merely an accessory which is placed on the outside of a conventional valve stem in order to obtain an additional sealing effect.

Q. 45. What is the material it is made of? A. The conical valve is made of metal; and also, the body and the seat of the valve are metal.

Q. 46. What would be the problem, if any, involved in getting an airtight seal between a metal valve and a metal seat? A. For the purpose of valve stems for use on pneumatic tires, it would be very impractical, because you could not obtain a good seal with a metal valve on a metal seat; that is because of the dust or other particles of foreign material that might enter in between the valve member and the seat.

59 By the Court:

Q. 47. Well, they have been doing that a long time, haven't they? A. No; I don't believe so. I think that if we go back over a period of years, in fact, since the early nineteen hundreds, all of the valve stems for inner tubes had a rubber sealing member—rubber, leather, cork, or some other resilient material.

The Court: All right.

By Mr. Burgess:

Q. 48. Now, will you please explain the construction shown in the French patent number 543,850? I suppose that would be next. A. The French patent shows a metal stem, a conical metal valve, and a rubber gasket against which the valve seats. This differs from the Eger construction in that the rubber gasket does not form any part of the stem itself. It is a separate member cemented to the inside of the metal valve stem and merely serves to increase the

sealing of the valve. There is a spring lying inside or below the conical valve and this urges the valve against the gasket.

Q. 49. Now, would it be possible to replace a valve of the construction shown in that French patent, in Figs. 1 and 2?

A. As shown in those figures, this construction is not replaceable unless the entire valve stem is dismantled from the inner tube.

Q. 50. Did the inventor in this French patent do anything in an effort to overcome that difficulty? A. The French

patent shows that he divided the valve into two parts; and that the upper part is in the form of an adapter screwed on to the main body of the valve stem. This, in effect, makes a two-part valve stem and forms an additional joint, which increases the possibility of valve leakage.

Q. 51. It was somewhat like the Knight structure in that respect, was it not? A. That is right.

Q. 52. How does the Eger structure avoid the difficulties which the Frenchman was endeavoring to overcome? A. Eger, by forming a valve body of rubber, using a metal valve member, made possible the withdrawal of the valve member, the conical valve member, through the top of the valve stem, thus making it replaceable; and Eger has only one point at which a joint is made and that is the valve seat itself. By comparison, the French patent shows three different joints.

Q. 53. Do I understand, then referring to the Eger drawing in the patent application involved in this suit, that the valve member can be pushed down beyond the rubber seat and then permitted to function to close the passage by contact with the rubber seat? A. Yes; that is correct.

Q. 54. While you are speaking of the Eger construction, what, if any, advantage is there in arranging the spring above the valve and seat, as contrasted with arranging it in the other way, with the spring below the valve and seat? A. There are important advantages, because if the spring

is above the valve and seat, the spring and the valve mechanism can be combined in one unit and can be withdrawn and inserted in the valve in one operation; whereas, 61 if the spring were below the valve, then it would form a separate part; and it would increase the cost and difficulties of the manufacturing operation.

Q. 55. What about the difficulty in getting the spring in place where you have it below the valve? A. If you were to place the spring below the valve and seat, it would be necessary for the spring to seat against a narrow rubber shoulder, and that would form an unstable seat for the spring; and there would be a possibility of the spring cocking off to one side and forming an improper seal.

Q. 56. What would be the effect upon the spring and the valve mechanism in the case of bending a valve stem, if the spring were below the valve instead of above it? A. One of the purposes of the rubber valve stem is to provide a flexible valve stem; and, if anything is inserted within the bore of the stem, it will interfere with the flexing of the stem; and vice versa, the flexing of the stem will interfere with the proper functioning of the valve mechanism.

Q. 57. If you have the spring above the valve, state whether or not any flexing that might take place in the major part of the stem would have any bad effect on the inside. A. If the spring is above the valve, then there would be no ill effects from the bending or flexing of the stem.

Q. 58. How important is it in a structure of this kind to be able to make it with a few parts and to assemble it with the smallest possible number of operations? A. The manufacture of valve stems has developed into a highly competitive business; and any reduction in the number of parts or any reduction in the assembly operation was always 62 looked forward to as a great accomplishment in the tire industry.

Q. 59. And that would be true, would it not, even if the valve, when completed, were not any better than the valve made in the other way? A. That is correct.

Q. 60. What are the advantages, if any, of a conical valve member as contrasted with a spherical valve? A. It does have some advantages because a spherical valve comes in contact with the rubber at a single tangent point; and, of course, due to the rubber being a resilient material, there is produced a considerable amount of strain at localized areas; whereas, with the conical valve, there is a relatively large seat and those strains are distributed over a correspondingly large area.

Q. 61. Would there be any danger that a spherical valve might make an indentation in the seat and possibly stick and possibly fail to function properly? A. There would be, due to the aging of the rubber. After the rubber has been in use over a period of time, it takes on a permanent set; and any pressure exerted against a particular local area of the rubber forms a permanent indentation.

Q. 62. And would that be likely to happen if you had a spherical valve? A. It would, because eventually you would have an opening the exact size of the spherical valve; and it would be difficult for that valve to function properly in an opening the same size as the valve itself.

63 Q. 63. Would that be likely to occur if you had a conical valve?

Mr. Reynolds: I think that is leading.

Mr. Burgess: I asked him if that same thing would be likely to happen with a conical valve.

The Court: You may go ahead.

A. With the conical valve, if there is any set in the rubber, the whole opening is correspondingly greater; therefore, there will not be any likelihood of the valve stem sticking with relation to the seat.

By Mr. Burgess:

Q. 64. Now, will you proceed, please, to describe the structure of the Sahuc patent, 1,475,554? A. The Sahuc patent discloses a metal stem; and there is a restricted portion in the bore of the stem to form a seat; that, of course,

is a metal seat. The sealing member, which is a conical valve, is made of rubber and it has a central metal stem attached to the rubber and extending upwardly and out of the end of the valve stem. The means for sealing is dependent entirely upon air pressure. In other words, there is no spring and no other functioning means to maintain the valve in a closed position.

Q. 65. How does the Sahuc patent describe the placing of the valve in position? A. The patent says that, in assembling the rubber core and the metal stem, the rubber core is forced through the narrow neck of the stem into a seating position.

Q. 66. Where are you reading from, what part of the patent? A. I am reading from the illustration.

64 Q. 67. Well, where does the patent specification state as to how the valve is put into place? A. On page 1, line 30, it states:

"The compressible mass may be freely introduced through the valve orifice j, and due to its compressibility may be forced through the cylindrical part of the neck c, by pressure."

Q. 68. Based upon your experience, what do you think of that procedure of placing that valve in place? A. According to the proportions illustrated in the drawing, it would be extremely difficult to force the rubber body through the neck of the valve stem.

Q. 69. How does Sahuc say that he takes this valve out if it has to be removed? A. In substantially the same way it is put in. It is forced outwardly.

Q. 70. What do you think of the possibility of removing that valve from the position shown in the drawings by the procedure stated in the patent? A. As a general rule, a valve of that type need only be removed from the valve stem after the stem has seen considerable service. In that event, the rubber would probably have deteriorated to some extent; and any attempt to force it through the narrow neck

would probably result in the breaking up of the rubber valve conical member and the fragments would then fall into the tube itself.

Mr. Burgess: I might say, if your Honor please, that in this Plaintiff's Exhibit 4 there appears also a notice of allowance. In other words, in an official notice that
65 was sent out, the Examiner allowed these claims that we are asking for here.

The Court: You refer to claims 24, 25, 26, 27 and 28?

Mr. Burgess: Yes, sir; those claims were allowed by the Examiner; and in this Plaintiff's Exhibit 4 there is included a certified copy of that notice of allowance. That is the regular notice that is sent out; and this one was sent out on February 10, 1941.

After that had been done, the Examiner then wrote a letter, which is also in this exhibit, withdrawing the allowance, in which he said that the reason that he withdrew the allowance—in other words, he changed his mind—was because he had misinterpreted some of the language of the claims in connection with these Watson patents; and it was because of the Watson patents and because of this change of the Examiner's view as to some of the words in these claims that are here in suit, that he then rejected the claims and made it necessary for us to take this action.

It seems to me that that is significant, because it shows that the Examiner was of the opinion at one time that these claims were patentable over these other patents. Therefore, if we can eliminate the Watson patents, by the manner that we have been discussing here today, which I need not repeat, then we come to what seems to me to be the obvious conclusion that the Patent Office Examiner thought these claims were patentable over everything except the Watson patents.

The Court: I am inclined to think so myself.

Mr. Burgess: I beg your Honor's pardon.

The Court: I am inclined to take that view myself.
66 I do not see that these other patents involve the same

principle that is involved in this application. Rather, the Watson patent is in your way.

Mr. Burgess: Well, I quite agree with your Honor, that, if we can not get it out of the way in the way that we have explained to you, then we have that difficulty; and I think your Honor is sound in both conclusions.

May I let Mr. Reynolds cross-examine the witness; and then we can argue it.

The Court: All right. Go ahead with the cross-examination.

Cross-examination by MR. REYNOLDS:

X-Q. 71. Now, it is common in this art to use conical valves, is it not—in the tire valve art that is? A. As a single feature, yes.

X-Q. 72. And it is old to use them with rubber seats, is it not? A. That also is, using them as a separate item, yes.

Mr. Burgess: You are speaking of 1932, not the present date?

Mr. Reynolds: I mean that it is old in the art, not that it is done now.

Mr. Burgess: I think it ought to be made plain to the witness.

By Mr. Reynolds:

X-Q. 73. So that any advantage you may have referred to as resulting from the use of the conical valve with a rubber seat is well understood in the art? A. Except
67 that it has not been shown in the prior art that a conical valve was used with a rubber stem in which the seat forms a part of the body of the stem.

X-Q. 74. I did not say anything about the seat forming a part of the body of the stem—did I? A. No.

Mr. Reynolds: Will you please answer the question?

The Witness: Repeat the question.

X-Q. 75. I say: Any advantage that may be inherent in the use of the conical valve with a rubber seat was known

before Eger made this supposed invention, wasn't it? A. That is generally correct; yes, sir.

X-Q. 76. Well, will you refer, please, to the Watson patent number 2,106,671, Fig. 5 of the patent? A. Yes.

The Court: You still have not convinced me yet that there is a rubber seat on this valve here.

Mr. Reynolds: I will agree that there is, your Honor.

The Court: You will agree that there is? The drawings show it?

Mr. Reynolds: I am referring to the drawing. I will admit that the drawing shows it.

The Court: It does not make any difference. This conical part of the valve fits right down into this metal receptacle anyway. You look at it.

(Demonstration by counsel for the parties, with samples, and sotto voce discussion at the bench was had.)

By Mr. Reynolds:

68 X-Q. 77. Will you refer to Fig. 5 of patent 2,106,671? You have that patent there?

The Court: That is the Watson patent?

Mr. Reynolds: That is part C of our exhibit, your Honor. A. I have that here.

By Mr. Reynolds:

X-Q. 78. Is that substantially what was referred to as Watson's invention, in the agreement of July, 1932? A. That is substantially correct; yes, sir.

X-Q. 79. Now, wouldn't it be a simple matter to put that spring above the valve instead of below it, if you wanted to? A. I do not think it would be, because a different principle is involved; you are urging it up through the passage against the pin rather than pressing it against the ball.

X-Q. 80. It is old to do that, is it not?

The Court: To put it above?

By Mr. Reynolds:

X-Q. 80 (continued) It is old to put the spring in that type of valve above the valve instead of below it, isn't it?

A. Not in that type of valve, no.

X-Q. 81. The Knight patent shows it, doesn't it? A. Yes; the Knight patent does show it.

X-Q. 82. In other words, if you gave that to a mechanic and told him you wanted the spring above the valve instead of below, he would know what to do, would he not? A. You also must have on it a means to hold it. You must also have a means by which the spring can be retained.

X-Q. 83. That valve stem in the Watson patent had a head that could be enlarged—the part 34—doesn't it?

69 A. Yes; but it has quite a mechanism in between the head and the valve.

X-Q. 84. Yes. But you can simply lower a guide, to put a spring in between them, couldn't you, the way Knight has done? A. That would amount to the redesigning of the valve stem.

X-Q. 85. Do you think it would be beyond an ordinary mechanic to do that? A. Well, it may be possible that a mechanic could do it.

X-Q. 86. Wouldn't you think that one of your mechanics could do it, if you were to tell him? A. It could be done; but it might not function properly. It would depend on how you seated the spring.

X-Q. 87. You could seat it the way Knight does, couldn't you? A. Yes; but, even then, if you will refer to Knight, you will find that he does not rely on the spring; he relies upon the cap above the valve stem.

X-Q. 88. But he has a spring? A. Yes; he has a spring. But, in reading that patent, you will find out that the spring is there only to take care of the initial pressure during the pumping; and after that is completed the seating of the valve is controlled by the cap on top; and his whole device is a merely check valve.

X-Q. 89. But the Knight patent shows how to mount a spring above the valve for urging the valve into engagement with the seat, doesn't it? A. It shows that general idea.

70 Mr. Reynolds: that is all.

The Court: Do you care to ask him anything further?

Mr. Burgess: Yes, your Honor.

Redirect examination

By Mr. Burgess:

Re-D. Q. 90. Suppose that an effort to substitute rubber for the metal of the Knight were made; would there be any problem involved there in locating the valve and the spring and the rest of the mechanism so as to make it function properly? A. I think there would be. It would require a considerable amount of testing and experimentation in order to obtain a proper functioning of the valve mechanism.

Mr. Burgess: That is all.

Mr. Reynolds: That is all.

The Court: Stand aside.

(The witness retired from the stand.)

Mr. Burgess: That is the case for the plaintiff, if the Court please.

Mr. Reynolds: I would like to offer as the Defendant's Exhibit 1 the folder which I handed your Honor to start with, consisting of copies of:

A	Knight patent	1,471,172
B	Sahuc patent	1,475,554
C	Watson patent	2,106,671
D	Watson patent	2,200,785
E	French patent	543,850
F	Print of Drawings	
G	Examiner's Statement	
H	Decision of the Board of Appeals.	

71 (The document so produced and identified was received in evidence and marked as Defendant's Exhibit 1.)

Mr. Reynolds: We have no further testimony.

* * * * *

86

Filed Jan 13 1944

III.

EXHIBITS.

Plaintiff's Exhibit No. 1

July 21, 1932.

Conference with Mr. F. H. Watson, Mr. E. L. Dean and Mr. R. F. Ternes Relative to Rubber Valves For Inner Tubes—Detroit, Mich.—July 21, 1932.

Mr. Watson showed us his drawing, dated May 28, 1931 and witnessed by Messrs. F. E. Godwin, E. L. Dean and Jas. L. Hearne.

He also showed us four cut and one uncut samples which have been prepared at Indianapolis under his direction during the last few days.

We in turn showed him Mr. Eger's drawing of a very similar invention on which a patent application has been submitted by us. This is the photostat of the drawing that was submitted with the patent application.

The main difference between the two ideas is that Mr. Eger has his spring above the sealing member and Mr. Watson proposes to put his below the sealing member. Mr. Watson's metal sealing member is spherical whereas Mr. Eger's is conical. Furthermore, Mr. Eger's stem carries a screwed on metal cap covering and metal nipple in place of a rubber one.

It is agreed that both parties will go on and develop their respective inventions to such a point that decision can be made as to which is the most desirable based on appropriate

tests of some sort. After this decision adequate commercial arrangements will be made.

SIDNEY M. CADWELL

SMC

ML

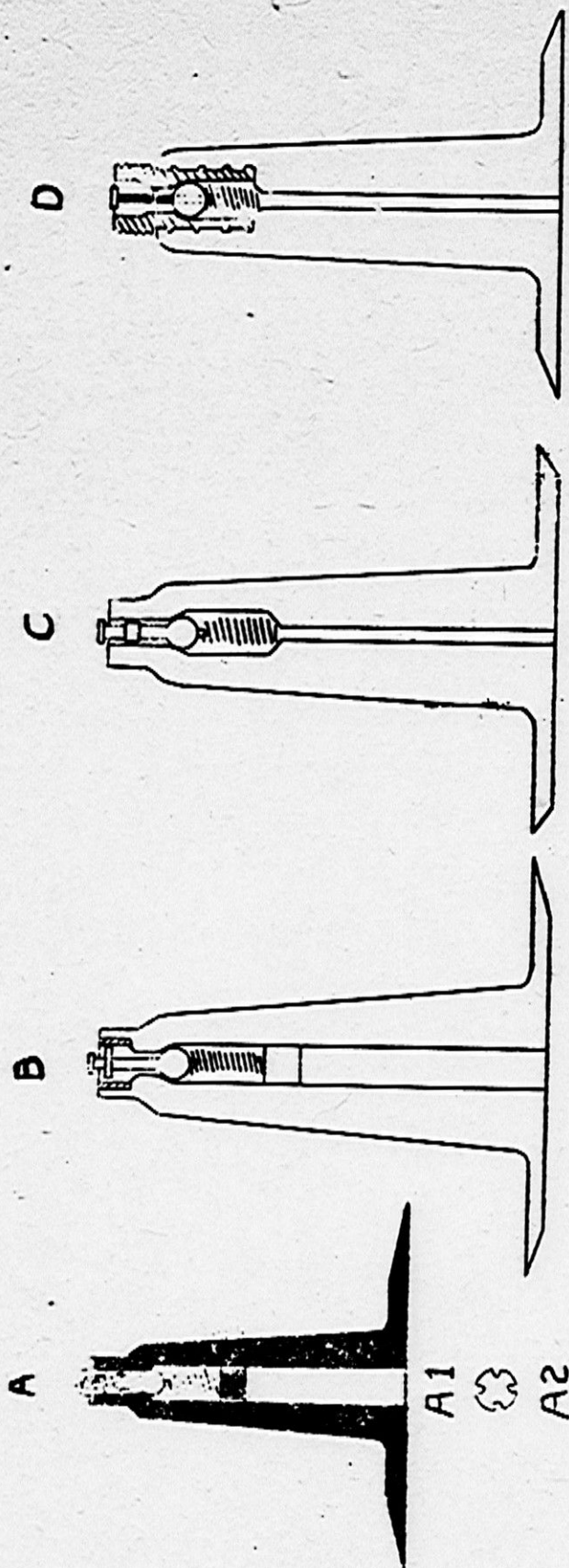
CC—Mr. F. H. Watson

Mr. E. L. Dean

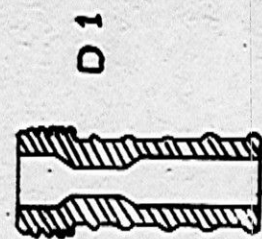
Mr. R. F. Ternes

Mr. W. L. Pipes

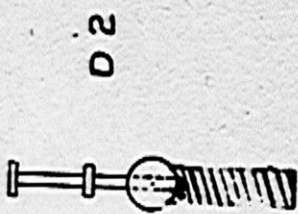
P. S. Mr. F. H. Watson signed the original copy of this memorandum.



A3



D1



D2

RUBBER VALVE STEMS AND INSIDES
FOR PNEUMATIC TIRES
DESIGNED BY F.H. WATSON
JONESBORO, ARKANSAS
MAY 28 1931

WITNESSES
[Signature]
[Signature]
[Signature]

P.F.'s EXHIBIT #2
L.R. 16-517

C.A. 16517

Pls. 3 id.

C.C. Dr. Cadwell

FILED

JAN 17 1944

RECEIVED & INDEXED, FBI

May be necessary to make
this shoulder detachable in
some way in order to assemble
spring and ball through the
aperture from the base of
the stem

Metal Nipple

Metal Ball

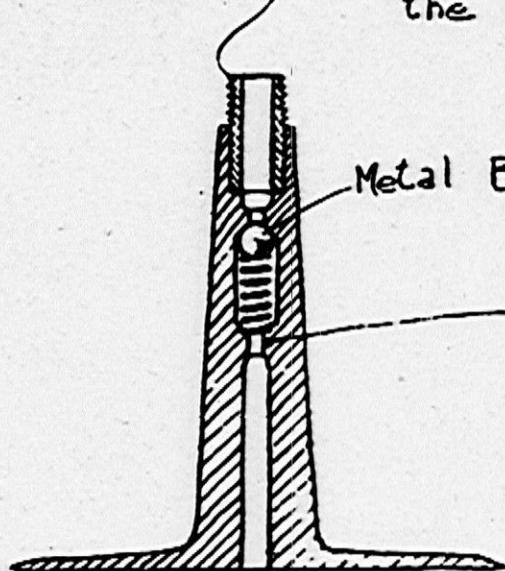


Fig. 1

Metal Nipple
and Valve Seat

Rubber Ball

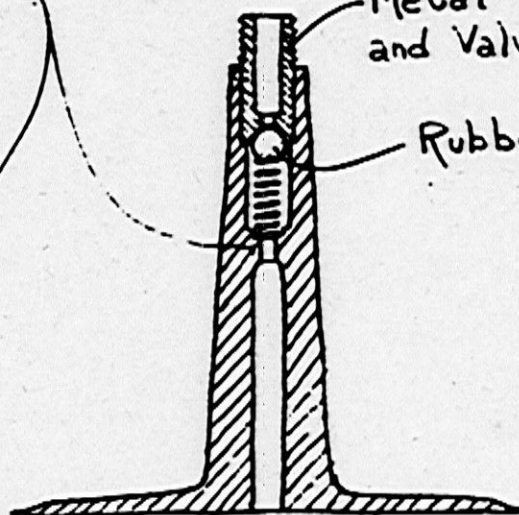


Fig. 2

Watson Valve Mechanism

PUP'S EXHIBIT #3

C.A. 16-517

(FOR IDENTIFICATION)

R.H.T.
7-29-32

Plaintiff's Exhibit No. 4

90

LGB.B 9/15/32

Specification.

To All Whom It May Concern:

Be It Known That I, Ernst Eger, a citizen of the United States, residing Grosse Pointe Park, County of Wayne, State of Michigan, have invented certain new and useful Improvements in Valve Mechanisms, of which the following is a full, clear and exact description.

My invention relates to valve mechanisms, and in particular to valve insides intended to be used in connection with valves for inner tubes of pneumatic tires. More particularly, the present invention is adaptable to that type of stem known as the "all rubber" valve stem.

Conventional types of valve insides generally provide a seat for the valve mechanisms, independent of the seat which admits and releases air to or from the inner tube. In the conventional type valve insides, leakage frequently occurs at the seat which forms the seal between the valve stem and the valve mechanism or core. In my invention, I provide only one valve seat, thus eliminating the usual cause of leakage.

Commercial use of the all rubber valve stem has required that the valve mechanism should be relatively short due to the flexibility of the stem. I provide a valve mechanism which does not extend into the bore of the free flexing portion of the stem, but is confined within a short metallic cap positioned at the end of the valve stem.

91 I also provide a valve stem which, in addition to its adaptability to the present valve mechanism, if properly proportioned, is also adaptable to conventional valve mechanisms. This interchangeability is of considerable importance where a new product is placed in the commercial field.

Further objects of my invention are to decrease the number of parts which make up the mechanism, and to elim-

inate sealing gaskets. A further object is to provide a valve inside which is more compact, simple in construction, and more economically manufactured.

Other objects and advantages become apparent in the following detailed description when considered in connection with the accompanying drawing, in which:

Fig. 1 is a side elevational view of the complete valve stem;

Fig. 2 is a greatly enlarged elevational view, in section, of the upper part of the stem and valve mechanism; and

Fig. 3 is a perspective view, partly in section, of the spring retainer sleeve.

Referring to the drawings, the numeral 1 indicates a valve stem having a base 2. The stem 1 is preferably composed of flexible material, such as rubber with or without fibrous or fabric reinforcement, although certain features of the invention are applicable to metallic valve stems. The top of the stem 1 is provided with coarse threads 3 (Fig. 2) upon which a cap or sleeve 4 is attached. This

cap 4 is attached to the rubber stem by being molded
92 and vulcanized thereon. As shown in the drawing, the bond between the metal cap 4 and the stem 1 need not be air tight for the reason that this union has no connection with the stem passageway or bore in which the fluid pressure is confined. Therefore, the bond need only be sufficient to retain the cap 4 in its relative position with the stem 1. In conventional rubber valve stems it is a general practice to provide a short nipple at the end of the rubber stem, which extends internally of the stem so as to provide in part a continuation of the stem bore. This condition is objectionable in that the joint between the nipple and the rubber stem, communicates directly with the stem aperture, thus requiring a good bonding condition between the rubber and metallic members. This undesirable condition is entirely overcome by my invention. Continuing or projecting from the top of sleeve 4 is an extension sleeve 5 which has external threads 6 upon which may

be screwed a conventional type of valve cap (not shown). The extension sleeve 5 has internal threads 7 in which a threaded end 8 of a spring retainer sleeve 9 is retained. A recess 10 forming an axially aligned chamber in the upper part of the stem 1 provides a clearance for the insertion of the spring retainer sleeve 9. The bottom of the recess 10 narrows inwardly to form a shoulder 11 and an aperture 12. A valve seat 13 is formed as a conical lower or inner surface of the shoulder 11 converging towards the aperture 12 and opening at its base to bore 14 of the valve stem.

93 The working parts of the valve mechanism comprise a valve pin 15 flared out at the bottom to form a conical valve head 16. A spring 17 is retained at the lower end by a rim 18 extending radially inwardly of the spring retainer sleeve 9. The upper end of the spring 17 engages with a spring retaining flange 19 at the uppermost part of the valve pin 15. The spring as thus assembled normally urges the valve pin 15 in an upward or outward direction so that the valve head 16 will fit tightly against the seat 13. As customary with valve insides, the threaded end 8 of the spring retainer sleeve 9 is provided with flat surfaces 20 (Fig. 3) for engagement with a conventional valve cap tool.

In rubber valve stems it is of considerable importance that the valve mechanism should be relatively short. The reason for this is that a long valve mechanism will interfere with the free flexing of the stem, and at the same time any flexing of the stem will interfere with the proper sealing function of the valve mechanism. This condition is entirely overcome by my invention in which I provide a valve mechanism confined entirely within the length of the metal cap at the end of the all rubber stem.

The narrow aperture 12 is of such size that the valve head 16 cannot normally pass therethrough. Due, however, to the flexible material of the stem 1, the valve head when inserted and given a firm downward pressure will cause the aperture 12 to distend sufficiently so that the valve

head 16 may pass therethrough. A lubricant, such as water, applied to the wall of aperture 12 or to the surface of the valve head 16 greatly facilitates the inserting operation.

94 After the valve mechanism is in proper actuating position, the pressure which the valve is designed to withstand is not sufficient, when reacting against the valve head 16, to cause the aperture 12 to distend. The seat 13 as provided in my invention is part of the all rubber stem itself, and forms a thick and substantial body for contact engagement with the valve head. This presents a further advantage for the reason that the small, thin sheet of rubber embodied in conventional valve mechanism is more susceptible to deterioration due to its comparatively localized compression.

Although a preferred embodiment of the invention has been illustrated and described herein, it is obvious that various modifications may be made without departing from the spirit and scope of the following claims.

95 Having thus described my invention, what I claim and desire to protect by Letters Patent is:
(Claims 1 to 10 of original specification omitted.)

* * * * *

98 Signed at _____, County of _____
State of _____, this _____ day of _____ 19 .

ERNST EGER

152112

635209

~~014~~ ← withdrawn
Mar. 18

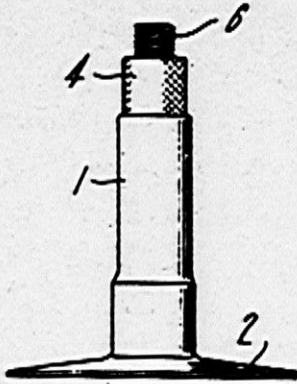


Fig. 1

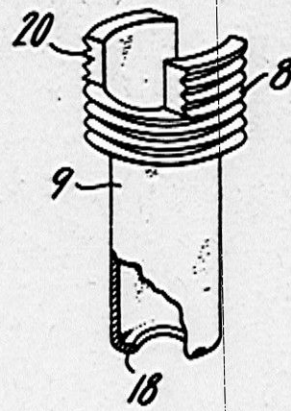


Fig. 3

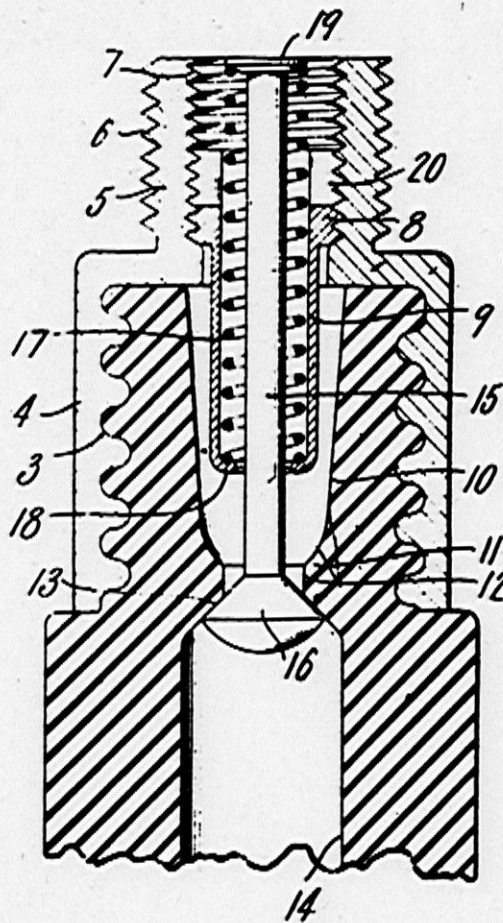


Fig. 2

635,106 694
Jan 6, 214 1115 T.Y.

INVENTOR
ERNST EGER
BY *Ernst Eger*
ATTORNEY

29 635 209 (10) 251-144

100

Jan 11 1941

Applicant: Ernest Eger
Ser. No. 635,209
Filed Sept. 28, 1932
For Valve Mechanisms

Lester G. Budlong,
Rockefeller Center,
1230 Sixth Avenue,
New York, N. Y.

Responsive to Amendment of Oct. 12, 1940

Claims 1 to 15, inclusive, and 20 to 23, inclusive, are canceled.

The rejection of claim 19 is repeated. The applicant argues that the metal band of Barrett does not suggest its use as a reinforcing means for the valve seat. It is observed that the claim does not define the metal portion as a reinforcing means for the integral seat.

Claims 16, 17, and 18 stand allowed.

Claims 24 to 28, inclusive, are allowable as now advised.

It is suggested that a statement be incorporated in the specification explaining the use of the ferrule 4 as a reinforcing means for the stem seat portion.

This action is made Final.

F. I. WHITNEY
Examiner.

Submitted Jan 10 1941 Supervisory Examiner

101 Div. 39 Room 4878 embl

Serial No. 635,209

Department of Commerce
United States Patent Office
Washington

February Ten 1941

Ernst Eger (Assor.)

Your Application for a patent for an Improvement in Valve Mechanisms filed Sept. 28, 1932 has been examined and Allowed with 9 claims.

The final fee, Thirty Dollars (\$30), With One Dollar (\$1) Additional For Each Claim Allowed In Excess Of 20, must be paid not later than 6 Months from the date of this present notice of allowance. If the final fee be not paid within that period, the patent will be withheld; See Revised Statutes, Section 4885 As Amended By Act Of Congress Approved August 9, 1939.

The office delivers patents upon the day of their date, on which date their term begins to run. The preparation of the patent for final signing and sealing will require about 4 weeks, and such work will not be begun until after payment of the necessary final fee.

When the final fee is paid, there should also be sent, Distinctly And Plainly Written, the name of the Inventor, Title Of The Invention, And Serial Number As Above Given, Date Of Allowance (which is the date of this circular), Date Of Filing, and, if assigned, the Names Of The Assignees.

If it is desired to have the patent issue to an Assignee Or Assignees, an assignment containing a Request to that effect, together with the Fee for recording the same, must be filed in this office on or before the date of payment of the final fee.

After issue of the patent, uncertified copies of the drawings and specifications may be purchased at the price of

Ten Cents Each. The money should accompany the order. Postage stamps will not be received.

The final fee will Not be received from other than the applicant, his assignee or attorney, or a party in interest as shown by the records of the Patent Office.

Notice.—When The Number Of Claims Allowed Is In Excess Of 20, No Sum Less Than Thirty Dollars (\$30) Plus One Dollar (\$1) Additional For Each Claim In Excess Of 20 Can Be Accepted As The Final Fee.

Respectfully,

CONWAY P. COE

Commissioner of Patents.

This Application Cannot Be Renewed

In Remitting The Final Fee Give The Serial Number At The Head Of This Notice

Uncertified Checks Will Not Be Accepted

Lester G. Budlong,
Rockefeller Center,
1230 6th Avenue,
New York, N. Y.

102 Mail Division May 23 1941 U. S. Patent
Office

In the United States Patent Office

Re: Application of
Ernst Eger
Serial No. 635,209
Filed September 28, 1932
Valve Mechanisms
Div. 39—Room 4878

Affidavit

Under Rule 75

State of Michigan, County of Wayne, ss:

Raymond F. Ternes, of mature age, being duly sworn deposes and says:

That he is a citizen of the United States and a resident of Detroit, County of Wayne, State of Michigan;

That he is a registered patent attorney;

That on or before July 1, 1932 he prepared a draft specification on behalf of Ernst Eger relating to Valve Mechanisms, of which the attached exhibits A, B, C and D are photostat copies, and the attached exhibit E is a photostatic copy of the drawing used and described by him in the draft specification, exhibits A, B, C and D;

That the numerals identifying the parts were applied by him in pencil on the original drawing which was sent to Walter L. Pipes, patent attorney for the United States Rubber Company, 1790 Broadway, New York City, on or about July 11, 1932;

That in preparing the patent specification, exhibits A, B, C and D, and the drawing exhibit E, he had before him a valve stem shown in the attached photograph marked exhibit F;

103 That the insert in the valve exhibit F shown partly protruding from the end of the stem is more clearly shown in an enlarged view in the attached photograph marked exhibit G;

That the copy of the specification exhibits A to D inclusive, the drawing E and the valve stem and insert from which photographs exhibits F and G were taken, have been in his possession continuously since on or before July 1, 1932;

That the patent specification as prepared by him was revised in the office of Walter L. Pipes and ultimately was filed in the United States Patent Office as application, Serial No. 635,209, September 28, 1932;

That from time to time during the prosecution of the aforesaid application, Serial No. 635,209 dated September 28, 1932, he has conferred with Lester G. Budlong, present patent attorney of record of the said Eger application, with reference to the prosecution of the application and has been present at conferences including himself, Ernst Eger, William M. Blackie and Lester G. Budlong;

That, to the best of his knowledge and belief, he does not know and does not believe that the invention of the said Eger application, Serial No. 635,209, dated September 28, 1932, has been in public use or on sale in this country, or patented or described in a printed publication in this or any foreign country for more than two years prior to the said Ernst Eger application, Serial No. 635,209, and, that he does not believe that the invention, of the said Ernst

Eger application, has ever been abandoned;

104 Further, deponent sayeth not.

RAYMOND F. TERNES

Subscribed and sworn to before me this 8th day of May, 1941.

E. A. MOST

(Seal)

Notary Public

My Commission Expires Sept. 22, 1942

105 *Specification.*

To All Whom It May Concern:

Be It Known That I, Ernst Eger, a citizen of the United States, residing at Grosse Pointe Park, County of Wayne, State of Michigan, have invented certain new and useful improvements in Valve Mechanisms, of which the following is a full, clear and exact description.

My invention relates to valve mechanisms, and in particular to valve insides intended to be used in connection with valves for inner tubes of pneumatic tires. More particularly, the present invention is adaptable to that type of stem known as the "all rubber" valve stem.

Conventional types of valve insides generally provide a seat for the valve mechanisms, independent of the seat which admits and releases air to or from the inner tube. In the conventional type valve insides, leakage frequently occurs at the seat which forms the seal between the valve stem and the valve mechanism. In my invention, I provide only one valve seat, thus eliminating the usual cause of leakage.

Commercial use of the all rubber valve stem has required that the valve mechanism should be relatively short due to the flexibility of the stem. I provide a valve mechanism which does not extend into the bore of the free flexing stem, but is confined within the short metallic cap positioned at the end of the valve stem.

Further objects of my invention are a decrease in the number of parts which make up the mechanism, and an entire absence of sealing gaskets. A further object is to provide a valve inside which is more compact, simple in construction, and more economically manufactured.

Other objects and advantages become apparent in the following detailed description when considered in connection with the accompanying drawing, in which:

Fig. 1 is a side elevational view of the complete valve stem;

Fig. 2 is a greatly enlarged elevational view, in section, of the upper part of the stem and valve mechanism; and

Fig. 3 is a perspective view, partly in section, of the spring retainer sleeve.

Referring to the drawing, the numeral 1 indicates a form of valve stem having a base 2. By way of example, this stem may be composed of flexible material, such as rubber with or without fabric reinforcement. The top of the stem is provided with coarse threads 3 (Fig. 2) upon which a cap or sleeve 4 is attached. Continuing or projecting from the top of sleeve 4 is an extension sleeve 5 which contains external threads 6 upon which may be screwed a conventional type of valve cap (not shown). The extension sleeve

5 has internal threads 7 in which a threaded end 8 of a spring retainer sleeve 9 is retained. A recess 10 forming an axially aligned chamber in the upper part of the stem 1 provides a clearance for the insertion of the spring
 107 retainer sleeve 9. The bottom of the recess 10 narrows inwardly to form a shoulder 11 and an aperture 12. Valve seat 13 is formed as a conical surface converging towards the aperture 12 and extending at its base to bore 14 of the valve stem.

The working parts of the valve mechanism comprise a valve pin 15 flared out at the bottom to form a conical valve head 16. A spring 17 is retained at the lower end by a rim 18 extending inwardly of the spring retainer sleeve 9. The upper end of the spring 17 engages with a spring retainer 19 forming a flange-like member at the uppermost part of the valve pin 15. The spring as thus assembled normally urges the valve pin 15 in an upward movement so that the valve head 16 will fit tightly against the seat 13. As customary with valve insides, the threaded end 8 of the spring retainer sleeve 9 is provided with flat surfaces 20 (Fig. 3) for engagement with a conventional valve cap tool.

In inserting the valve mechanism in the stem it is noted that the narrow aperture 12 is of such size that the valve head 16 cannot normally pass therethrough. Due, however, to the flexible material of the stem 1, the valve head when inserted and given a firm downward pressure will cause the aperture 12 to distend sufficiently so that the valve head 16 may pass therethrough. A lubricant, such as water, applied to the wall of aperture 12 or to the surface of the valve head 16 greatly facilitates the inserting operation.

After the valve mechanism is in proper actuating position, the pressure which the mechanism is designed
 108 to withstand is not sufficient, when reacting against the valve head 16, to cause the aperture 12 to distend. The seat 13 as provided in my invention is part of the all rubber stem itself, and forms a thick and substantial body for contact engagement with the valve head. This

presents a further advantage for the reason that the small, thin sheet of rubber embodied in conventional valve mechanisms is more susceptible to deterioration due to its comparatively localized compression.

Although a preferred embodiment of the invention has been illustrated and described herein, it is obvious that various modifications may be made without departing from the spirit and scope of the following claims.

* * * * *

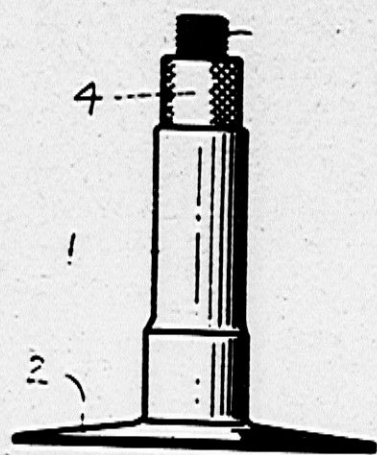


Fig. 1

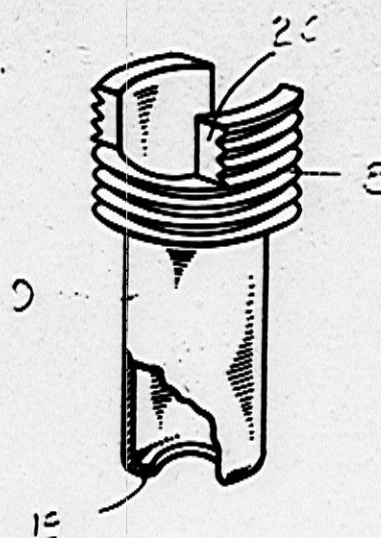


Fig. 3

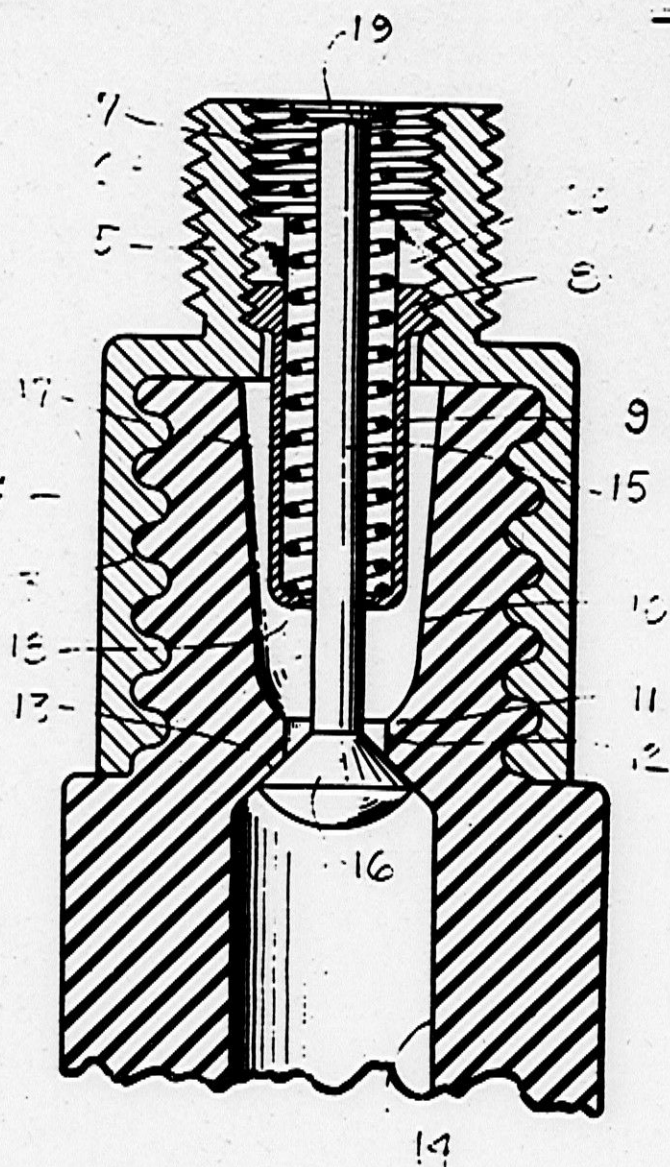


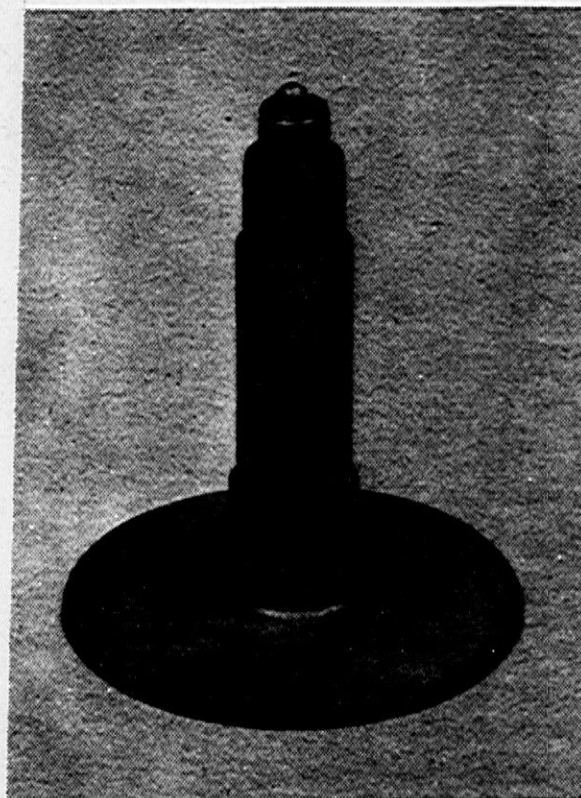
Fig. 2

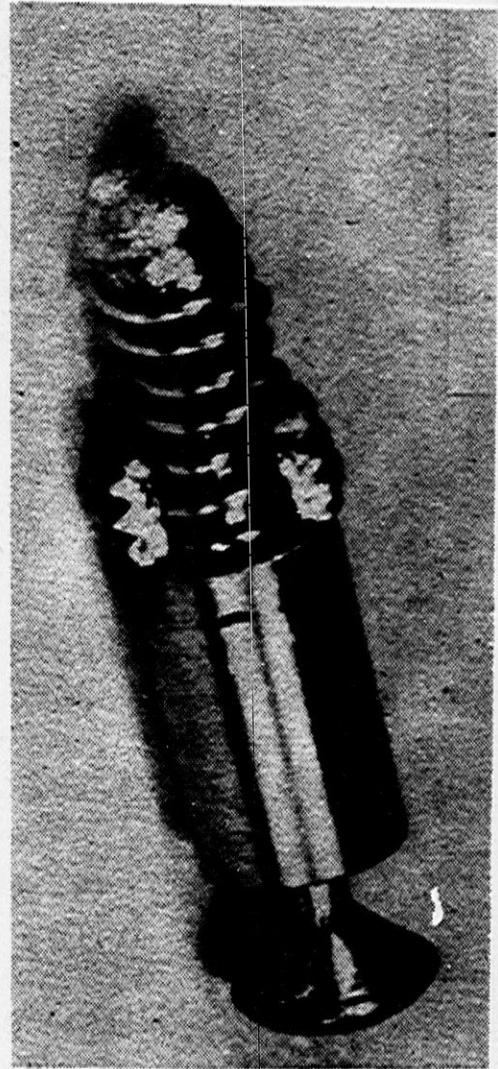
635 209

INVENTOR.

BY

ATTORNEYS.





112 In the United States Patent Office

Re: Application of
Ernst Eger
Serial No. 635,209
Filed September 28, 1932
Valve Mechanisms
Div. 39—Room 4878

Affidavit

Under Rule 75

State of Michigan, County of Wayne, ss:

Ernst Eger, of mature age, being duly sworn deposes and says:

That he is a citizen of the United States and a resident of Grosse Pointe Park, County of Wayne, State of Michigan;

That he is the applicant for application of Letters Patent, Serial No. 635,209, dated September 28, 1932;

That he has read the affidavits of Raymond F. Ternes and William M. Blackie attached hereto and concurs with the statements contained therein;

That prior to July 1, 1932 he reviewed a draft patent specification covering the invention of application, Serial No. 635,209 identified as exhibits A, B, C and D and a drawing exhibit E attached to the affidavit of Raymond F. Ternes;

That he has examined the valve stem and valve insert from which photographs identified as exhibits F and G in the Ternes' affidavit were made, and that he delivered the valve stem and valve insert in competed condition to Mr. Ternes prior to July 1, 1932;

113 That to the best of his knowledge and belief the materials from which exhibits A to G inclusive were prepared have been in the possession of Mr. Ternes since at least July 1, 1932;

That he has had numerous occasions to discuss his application, Serial No. 635,209 with Messrs. Raymond F. Ternes, William M. Blackie and Lester G. Budlong;

That other valve stems similar to the valve stem shown in Ternes' exhibits E and G are in his possession, one of said units being a valve stem assembled with an inner tube, as shown in the attached photograph marked exhibit H, which unit has been in his possession since prior to July 1, 1932;

That prior to filing his application, Serial No. 635,209 on September 28, 1932, he does not know and does not believe that the invention has been in public use or on sale in this country, or patented or described in a printed publication in this or any foreign country for more than two years prior to his application, and, that he has never abandoned the invention.

Further, deponent sayeth not.

ERNST EGER

Subscribed and sworn to before me this 8th day of May, 1941.

(Seal) E. A. MOST,
Notary Public

My Commission Expires Sept. 22, 1942.



115 Mail Division May 23 1941 U. S. Patent Office

In the United States Patent Office

Re: Application of

Ernst Eger

Serial No. 635,209

Filed September 28, 1932

Valve Mechanisms

Div. 39—Room 4878

Affidavit

Under Rule 75

State of Michigan, County of Wayne, ss:

William M. Blackie, of mature age, being duly sworn deposes and says:

That he is a citizen of the United States and a resident of Detroit, County of Wayne, State of Michigan;

That he has been an assistant to Raymond F. Ternes in the consideration and handling of inventions and the preparation of patent applications for and on behalf of the United States Rubber Company, and associate company at Detroit, Michigan, since on or before July 1, 1932 and that in such capacity he has penciled and inked many patent drawings;

That he has read the attached affidavit of Raymond F. Ternes and he has examined the record copy of the photostat of the drawing exhibit E and that he made the original Patent Office drawing on or before July 1, 1932;

That he is certain that the original valve stem and valve insert shown in exhibits F and G referred to in the affidavit of Raymond F. Ternes, have been in Mr. Ternes' possession since on or before July 1, 1932;

116 That he supervised the preparation of the photostats of the drawing including the record copy of the photostat of exhibit E which were sent to the office of Walter L. Pipes and he recognizes Mr. Ternes' penciled nu-

merals thereon and that it was the custom in 1932 for Mr. Ternes to forward the preliminary drafts of patent specifications and drawings to Walter L. Pipes in New York, N. Y. in order that the latter and his associates might revise them and ultimately file patent applications;

That he has had occasion to discuss the Ernst Eger application, Serial No. 635,209 dated September 28, 1932, with Messrs. Ernst Eger and Raymond F. Ternes from time to time during its pendency before the Patent Office;

That, to the best of his knowledge and belief, he does not know and does not believe that the invention of the said Eger application, Serial No. 635,209, dated September 28, 1932 has been in public use or on sale in this country, or patented or described in a printed publication in this or any foreign country for more than two years prior to the said Ernst Eger application, Serial No. 635,209, and that he does not believe that the invention, of the said Eger application, has ever been abandoned.

Further, deponent sayeth not.

WILLIAM M. BLACKIE

Subscribed and sworn to before me this 8th day of May, 1941.

(Seal) E. A. MOST,
Notary Public

My Commission Expires Sept. 22, 1942.

* * * * *

142 *Excerpts from Defendant's Exhibit 1.*

Department of Commerce
United States Patent Office
Washington

On Appeal No. 41,505 to the Board of Appeals

In Re: Application of Ernst Eger Serial No. 635,209
Filed Sept. 28, 1932 For: Valve Mechanisms

Lester G. Budlong, Atty.

Examiner's Statement

This is an appeal from the final rejection of claims 24 to 28, inclusive. Claims 16 to 19, inclusive are allowed and claims 1 to 15, inclusive, and 20 to 23, inclusive, are canceled.

The Invention

The invention relates to a pneumatic tire valve and a rubber stem member 1 having a bore 14 therethrough, a constriction 12 formed in the bore intermediate the ends thereof, the walls of the bore and the constriction being yieldable, a body element axially shiftable relative to said stem including a valve head 16 of less diameter than the constriction, the valve head being adapted when forced through the constriction to be pressed by a spring 17 against the constricted portion to seal said bore against flow of air and being adapted to be forced from sealing engagement with the constricted portion to permit air
143 to pass into the tire, and a metal portion for supporting the spring housing 9, spring 17 and the valve pin 15, said metal portion surrounding the end of the stem 1 and extending to the valve seat 13 to reinforce said seat against lateral distortion.

The References

Art Applied:

Watson	2,106,671	January 25, 1938
Watson	2,200,785	May 14, 1940
Knight	1,471,172	Oct. 16, 1923
Sahuc	1,475,554	Nov. 27, 1923
French pat.	543,850	June 10, 1922

In Fig. 1 of Watson 2,200,785 is shown a rubber tire stem 10, having a constricted seat portion 18 against which a ball valve 23 is pressed by means of a spring 24. The seat portion 18 is reinforced against lateral distortion by the tubular metal portion 19 having its lower end 20 embedded in the rubber stem about the seat 18. The ball 23 has a pin 25 guided in the spider 26 with its upper end threaded to be engaged in the socket 33 of the cap 31 to positively hold the ball seated against seat 18. When the tire is to be inflated the cap 31 is removed and the air forced by the valve 23 and through the bore 14 into the tire.

In Fig. 5 of Watson is shown a modification wherein the valve 38 is urged against the rubber seat 37 by a spring 46 acting through the guide 45 and pin 43. The metal reinforcing member for the seat is shown at 39 having its lower end embedded in the rubber stem about the seat 37.

The other modifications of the Watson patent are 144 not relied upon and will not be discussed.

The Watson patent 2,106,671 shows in Fig. 12 a valve which is a duplicate of Fig. 5 of the other Watson patent which has been described in connection therewith and no further discussion of the Fig. 12 is thought necessary. The other modifications of the second mentioned Watson patent are not relied upon.

Sahuc shows a tire valve stem A having a compressible valve head D which is assembled by compressing the head as it is forced through the restricted passage at C by pushing on the end F of the pin E. The head D is held seated by the air pressure within the tire.

Knight shows an extension 5 for threading upon the end of a valve stem. The valve head is held upon the seat 8 by means of spring 14 which acts between the member 15 on the valve pin 10 and the spider 11. The cap 16 is screwed to the outer end of pin 10 when the valve is not in use.

The French patent 543,850 shows a tire valve stem M into which the valve member a' is screwed. The conical valve head o is pressed against the rubber seat B by means of the spring C supported by the spider D. The member h is merely a cap to close the outer end of the valve housing a' when not in use.

The claims are as follows:

Claim 24. A valve stem comprising a molded body of flexible material having base and tip portions and an axial air passage extending therethrough from the base to
145 the tip portions, said body having a restricted portion sloping inwardly of the passage and toward the tip portion providing an inwardly tapering surface forming a valve seat, a valve element disposed in the passage and having a conical surface for engaging the tapering body surface, metallic means associated with the stem exteriorly of the body seat and serving as a reenforcement for said seat, a pin carried by the valve element and extending longitudinally of the passage toward the stem tip, and a metallic spring associated with said pin and disposed within and operatively supported by said metallic means for urging the valve element to its closed position to cause passage sealing engagement between said tapering and conical surfaces.

Claim 25. A valve stem comprising a molded body of flexible rubber composition having base and tip portions and an axial air passage extending therethrough from the base to the tip portions, said body having a restricted portion sloping inwardly of the passage and toward the tip portion providing an inwardly tapering surface forming a valve seat, a valve element disposed in the passage and having a conical surface for engaging the tapering body

surface, metallic means associated with the stem exteriorly of the body seat and serving as a re-enforcement for said seat, a pin carried by the valve element and extending longitudinally of the passage toward the stem tip, and a metallic spring associated with said pin and disposed within and operatively supported by said metallic means for urging the valve element to its closed position to cause passage sealing engagement between said tapering and conical surfaces.

Claim 26. A valve stem comprising a molded body of flexible material having base and tip portions and an axial air passage extending therethrough from the base to the tip portions, said body having a restricted portion sloping inwardly of the passage and toward the tip portion providing an inwardly tapering surface forming a valve seat, a valve element disposed in the passage and having a conical surface for engaging the tapering body surface, metallic means associated with the stem exteriorly of the body seat and serving as a re-enforcement for said seat, a pin carried by the valve element and extending longitudinally of the passage toward the stem tip, and a metallic
 146 spring enclosing said pin and disposed within and operatively supported by said metallic means for urging the valve element to its closed position to cause passage sealing engagement between said tapering and conical surfaces.

Claim 27. A valve stem comprising a molded body of flexible material having base and tip portions and an axial air passage extending therethrough from the base to the tip portions, said body having a restricted portion sloping inwardly of the passage and toward the tip portion providing an inwardly tapering surface forming a valve seat, a valve element disposed in the passage and having a conical surface for engaging the tapering body surface, metallic means associated with the stem exteriorly of the body seat and serving as a re-enforcement for said seat, a pin carried by the valve element and extending longitudinally of the passage toward the stem tip, a metallic spring en-

closing said pin and disposed within and operatively supported by said metallic means for urging the valve element to its closed position to cause passage sealing engagement between said tapering and conical surfaces, and a spring seat carried by the pin for imparting longitudinal movement thereto.

Claim 28. A valve stem comprising a molded body of flexible material having base and tip portions and an axial air passage extending therethrough from the base to the tip portions, said body having a restricted portion sloping inwardly of the passage and toward the tip portion providing an inwardly tapering surface forming a valve seat, a valve element disposed in the passage and having a conical surface for engaging the tapering body surface, metallic means associated with the stem exteriorly of the body seat and serving as a reenforcement for said seat, a pin carried by the valve element and extending longitudinally of the passage toward the stem tip, a metallic spring enclosing said pin above said valve element and disposed within and operatively supported by said metallic means for urging the valve element to its closed position to cause passage sealing engagement between said tapering and conical surfaces, and a spring seat carried by the pin for imparting longitudinal movement thereto.

147 Claims 24 to 28, inclusive, of the Eger application were rejected as unpatentable over Fig. 12 of Watson 2,106,671 or Fig. 5 of Watson 2,200,785 with a conical valve substituted for the ball valve of either Watson patent as suggested by each Knight, Sahuc, and the French patent.

The claims were further rejected as unpatentable over Fig. 1 of Watson 2,200,785 with a conical head substituted for the ball of Watson and with spring mounted above the ball instead of below it as suggested by Knight.

It should be noted that the French patent 543,850 shows a conical valve head seated on a conical rubber valve seat as is the case in appellant's device.

The applicant argues that during interference No. 69,225 (decided adversely to appellant) with the application of

the Watson patent 2,200,785, Watson introduced an Exhibit 5 which contained the following statement by Watson:

"The main difference between the two ideas is that Mr. Eger has his spring above the sealing member and Mr. Watson proposes to put his below the sealing member. Mr. Watson's metal sealing member is spherical whereas Mr. Eger's is conical. Furthermore, Mr. Eger's stem carries a screwed-on metal cap covering and metal nipple in place of a rubber one."

Appellant states that the above statement was made on July 21, 1932 and is prior to August 15, 1932, the
148 filing date of the Watson patent 2,106,671 with which the appellant was in interference. Appellant argues that the said exhibit No. 5 is sufficient ground for withdrawing the Watson patent as a reference. Furthermore, the appellant has submitted affidavits which are drawn prior to the filing date of the said Watson patent and prior to the date of Exhibit No. 5 which he argues overcome the Watson patent as a reference, under the provisions of Rule 75.

The above points have been considered but it is the Examiner's opinion that since priority in the interference involving the present application and the application of the Watson patent 2,200,785 was awarded to Watson, the appellant cannot now overcome the Watson patent under Rule 75 or by Exhibit No. 5 of said interference.

It is therefore held that the Watson patent 2,200,785 is a good reference for all it discloses and may also be combined with other art. The copending application of Watson patent 2,106,671 was introduced as evidence during the interference proceedings and is now available as art against the appellant.

In conclusion, the conical valve head and the spring mounting above the valve, which the appellant states was admitted by Watson in Exhibit No. 5 to be the distinguishing reatures of appellant's device over the Watson device are both old and well known features which when combined with Watson's reinforced seat as suggested by the secondary art will not support a separate patent.

It should be noted that the metallic means 20 of Fig. 1 and 39 of Fig. 5 of Watson 2,200,785 and 75 of Fig. 12 of Watson 2,106,671 are associated with the body seats 17, 35, and 73 of the respective figures of the two patents and serve as reenforcements for said seats as recited in lines 8 to 10 of each of the rejected claims 24 to 28.

Respectfully submitted,

F. I. WHITNEY,
Examiner—Div. 39.

150

Paper No. 40

Decision of the Board of Appeals

U. S. Patent Office, Board of Appeals, Feb. 27 1942.

Appeal No. 41,505

Hearing February 10, 1942

In the United States Patent Office

Before the Board of Appeals

Ex Parte Ernst Eger

Application for Patent filed September 28, 1932, Serial No. 635,209. Valve Mechanisms.

Mr. Lester G. Budlong for applicant.

This is an appeal from the final rejection of claims 24 to 28.

Claim 24 is illustrative.

24. A valve stem comprising a molded body of flexible material having base and tip portions and an axial air passage extending therethrough from the base to the tip portions, said body having a restricted portion sloping inwardly of the passage and toward the tip portion providing an inwardly tapering surface forming a valve seat, a valve element disposed in the passage and having a conical surface for engaging the tapering body surface, metallic means associated with the stem exteriorly of the body seat and serving as a reenforcement for said seat, a pin carried by the valve element and extending longitudinally of the

passage toward the stem tip, and a metallic spring associated with said pin and disposed within and operatively supported by said metallic means for urging the valve element to its closed position to cause passage sealing engagement between said tapering and conical surfaces.

The references relied upon by the examiner are as follows:

	French Patent	543,850	Jun. 10, 1922
151	Knight	1,471,173	Oct. 16, 1923
	Sahuc	1,475,554	Nov. 27, 1923
	Watson	2,106,671	Jan. 25, 1938
	Watson	2,200,785	May 14, 1940

The appealed claims have been rejected in the first instance upon each of the patents to Watson disclosing the same structure as defined in the claims except that a spherical valve member is shown by Watson rather than a valve having a conical configuration supplemented by the showing of Knight, Sahuc or French patent 543,850 disclosing conical shaped valves in equivalent relation.

In respect to Watson, it appears that priority was decided adversely to applicant in an interference involving Watson's cases. It is applicant's contention that a certain statement made in Exhibit 5 of Watson in the testimony of record should be taken as indicating that Watson did not invent the particular limitation of the claims requiring that the spring be disposed relatively toward the outer end or tip of the valve stem.

On careful consideration of this situation, it is found that the clause referred to merely states that, "the main difference between the two ideas is that Mr. Eger has his spring above the sealing member and Mr. Watson proposes to put his below the sealing member". We do not regard this statement controlling in this situation for the reason that it is general in nature and does not definitely exclude the species where the spring is outwardly of the valve. It does not necessarily limit Watson's structure to a situation where the

spring must be inwardly of the valve. The statement that Watson proposes to put his spring below or inwardly of the valve or sealing member does not say that it may
152 not be outwardly thereof and Watson's patents, as pointed out by the examiner, disclose that arrangement.

We are in full agreement with the examiner's conclusion that Watson is a valid reference against the terms of the claims in the above respect and that mere change of valve from spherical to conical shape as shown to be known in the prior art by the collateral citations is not a patentable difference.

The decision of the examiner is affirmed.

W. L. REDROW,
Examiner -in-Chief

B. PIERCE
Examiner -in-Chief

J. W. CLIFT
Examiner -in-Chief
Board of Appeals.

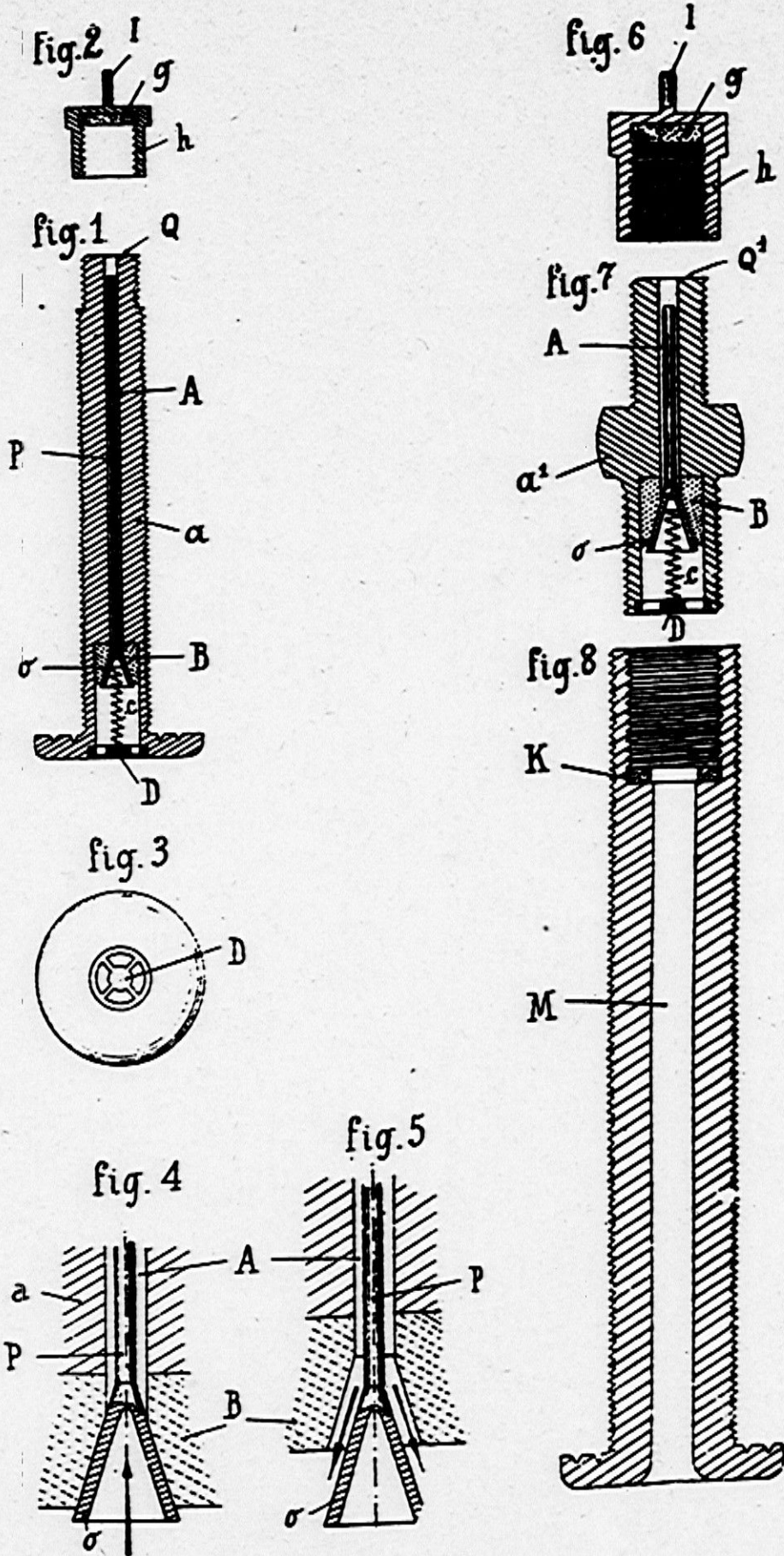
February 27, 1942.

MR. LESTER G. BUDLONG,
Rockefeller Center,
1230 6th Ave.,
New York, N. Y.

N° 543.850

M. Le Guelloc

Pl. unique



- 137 *Translation of French patent no. 543850, class V-3, to Joseph Le Guellec residing in France (Seine), applied for Nov. 23, 1921, granted June 10, 1922, published Sept. 9, 1922.*

Improved valve.

The present invention has for object a value system particularly applicable to the inner tubes of automobiles, motorcycles, bicycles and to any receptacle in which we wish to preserve a fluid under pressure.

The value which is the object of this invention has the following features: first the seat of the value is formed by a plastic material, suitably moulded, preferably vulcanized and which is cemented to the inside of the valve. Secondly, the metal valve is formed like a truncated cone hollowed out internally which reduces the weight.

The description which follows with due reference to the accompanying drawing, given by way of example, will render readily understood the manner in which the invention is realized.

Fig. 1 shows, in section, on a larger scale, a valve for bicycles and motorcycles, not demountable.

Fig. 2 shows the plug of the valve.

Fig. 3 is a bottom view of fig. 1.

- 138 Figs. 4 and 5 show diagrammatically the operation of the valve.

Figs. 6, 7 and 8 are detached views of the various elements of a demountable valve for automobiles or motorcycles, fig. 6 showing the plug, fig. 7 the demountable portion of the valve which, in current automobile language, is called "the inside" and fig. 8 showing the portion of the valve fixed on the inner tube.

The valve body a (fig. 1) or the inside a¹ (fig. 7) is pierced with a central hole A as an air passage; the lower part is bored to a diameter great enough to hold the seat B of the valve of which seat is composed of a plastic material such as rubber or a mixture having the same properties.

This seat is, first of all, coated with a vulcanizing cement so that after the seat has been put in place it is sufficient to heat the valve body a or the piece a¹ to a temperature sufficient for the seat B to be integral with the body a or the piece a¹. In the lower end of the valve body a (fig. 1) or of the piece a¹ (fig. 7) there is provided a small recess or seat permitting the insertion therein of a disc D pierced with holes for the passage of air and capable of serving as a guide for a light spring c which would compensate for the weight of the valve is that is thought necessary and in particular to prevent it from falling into the interior of the chamber (fig. 1).

139 It is to be noted that the length of the rod P of the valve must be calculated in such a way that in the event of excessive tightening up of the plug h the piece of leather (washer) g which is positioned within said plug will not come to rest on the end of the rod; in other words it is necessary that the end of the rod P of the valve shall be at a certain distance, for example 3 mm. at least, from the end of the outer edge Q of the valve body (fig. 1) or the edge Q₁ of the piece a¹ (fig. 7).

The safety plug h will permit us to have absolute tightness in both cases; it is provided with a point I sufficient long enough to be introduced into the passage A and press on the valve rod for the deflation of the inner tube or container.

In the case of a demountable valve, figs. 6, 7 and 8, the interior a¹ screws into the valve body and the joint is obtained by a disc of plastic material K on which it is tightened up. The valve body is pierced with a central hole M.

As we see in the drawing the conical valve o is hollowed out interiorly which renders it extremely light. This valve is pressed very strongly against its seat by the compressed air of the inner tube and, as the seat is of plastic material, there results therefrom an absolute tightness even if the seat is not perfectly cemented because of the fact that the said seat is strongly compressed against the inner wall of the valve body a or the piece a¹.

The invention relates to a valve system, demountable or not, particularly applicable to bicycles, motorcycles, automobiles, etc. which valve has the following features which may be present singly or in combination.

1. The valve seat is formed by a plastic material such as rubber and has along its axis a conical recess in which enters the valve of rigid material, for example metal.

2. The frustoconical valve is hollowed out which diminishes its weight.

3. At the base of the valve body or of the piece called "inside" is lodged a disc pierced with holes which can serve as a support for a spring the other end of which exerts pressure against the bottom of the valve.

4. The plug has externally a stud permitting us to disconnect the valve by engagement of the said stud in the valve, this plug being capable of receiving an internal packing of a disc of plastic material, of rubber for example, designed to insure an airtight closure of the valve.

TR/CP.

* * * * *

**SUPPLEMENTAL BRIEF FOR APPELLANT AND
STIPULATION AS TO ALLOWED CLAIMS.**

IN THE
United States Court of Appeals

DISTRICT OF COLUMBIA.

No. 8710

UNITED STATES RUBBER COMPANY, A CORPORA-
TION ORGANIZED UNDER THE LAWS OF THE
STATE OF NEW JERSEY, *Appellant*,

v.

CONWAY P. COE, COMMISSIONER OF PATENTS
AND/OR HIS SUCCESSOR IN OFFICE, *Appellee*.

**Appeal from the District Court of the United States for the
UNITED STATES District of Columbia.
COURT OF APPEALS FOR THE
DISTRICT OF COLUMBIA**

FILED DEC 7 - 1944

Joseph W. Stewart

CLERK
NEWTON A. BURGESS,
LESTER G. BUDLONG,
RALPH B. STEWART,
National Press Bldg.,
Washington, D. C.,
Of Counsel.

GIFFORD, SCULL & BURGESS,
141 Broadway,
New York, N. Y.,
Attorneys for Plaintiff-Appellant.

PRINTED BY BYRON S. ADAMS, WASHINGTON, D. C.

*Service acknowledged
Dec. 7, 1944
W. W. Cochran
att. for appellee*

TABLE OF CONTENTS.

	Page
Supplemental Brief	1
1. Does the Reasoning of the Monsanto Case Apply to the Present Situation?	2
2. Are the Interests of Watson (a Party to an Inter- ference with Eger in the Patent Office) Adversely Affected By This Proceeding and Should Watson Have Been Made a Party Hereto?	3
Stipulation as to Allowed Claims	8

TABLE OF CASES.

<i>Central Railway Signal Co. v. Jackson</i> , 254 F. 103, 106	7
<i>In Re Grieve</i> , 45 App. D. C. 524	4
<i>In Re Leins</i> , 33 U. S. P. Q. 446 (Patent Office Board of Appeals)	4
<i>Monsanto Chemical Co. v. Coe</i> , 62 U. S. P. Q. 37	1
<i>O'Reilly v. Morse</i> , 15 How. 62, 122, 133-4; 56 U. S. 62..	6
<i>Thacher v. Mayor and City Council of Baltimore</i> , 219 F. 909, 910	4
<i>Thomson-Houston Co. v. Ohio Brass Co.</i> , 80 F. 712, 726-7 (C. C. A. 6)	6

IN THE
United States Court of Appeals

DISTRICT OF COLUMBIA.

No. 8710.

UNITED STATES RUBBER COMPANY, *Appellant*,
v.
CONWAY P. COE, COMMISSIONER OF PATENTS,
Appellee.

Appeal from the District Court of the United States for the
District of Columbia.

SUPPLEMENTAL BRIEF FOR APPELLANT.

At the argument of the above case on November 17, the Court requested further information on the following points:

1. Whether or not the reasoning of the Court in *Mon-santo Chemical Co. v. Coe*, 62 U. S. P. Q. 37, applies to the present case.

2. Are the interests of Watson (a party to an interference with Eger in the Patent Office) adversely affected by this proceeding and should Watson have been made a party hereto?

1. Does the Reasoning of the Monsanto Case Apply to the Present Situation?

As we understand the *Monsanto* case, it is primarily concerned with whether or not the claims granted by the Patent Office conform with the Constitutional provision that patents "should be granted to promote science and the useful arts". If so, there is no objection to a reasonable number of claims, whereas if the claims are so constructed that they violate the purpose of the Constitution they should not be granted.

The record in this case was made long prior to the coming down of the decision in the *Monsanto* case and therefore there is nothing in this record which is specifically directed to the above question.

It is submitted that the present case does not come under the *Monsanto* decision because there is only one invention present here and that is a simple mechanical device. As stated by the Court in that case (p. 41):

"Mechanical invention is on the circumference of the inventive circle where there is plenty of room"

and on a device such as that forming the subject matter of the present case the claims are "of little scope and are safe enough."

At the hearing the Court asked whether or not any claims had been allowed in this case and was informed that some claims had been allowed. These claims are set forth in a stipulation submitted herewith (see page 8).

When the allowed claims are compared with those before the Court it will be found that there are two differences between the two sets of claims. In the allowed claims the metal reinforcing member 4 for the rubber valve seat is

specifically stated as being externally of the *casing*, whereas in the claims before the Court this member is stated to be externally of the body *seat*. The claims before the Court are limited to a conical valve and cooperating seat. In both sets of claims, of course, these elements are claimed in combination with other elements specifically recited in the respective claims and, as plaintiff contends, the combination is patentably different from the art cited. It is not appropriate to discuss the subject of patentability in this memorandum, but we remind the Court that at the hearing the defendant admitted that the claims before the Court were patentably different from all of the prior art cited except the Watson patents. This is mentioned here because it was not so stated in defendant's brief.

It is believed that a reading of the allowed claims and of the claims before this Court will clearly show that they are of such a character as to promote science and the useful arts and in no way violate the Constitutional mandate.

Plaintiff, of course, has no desire to secure more claims than are necessary on the Eger device, but believes that finding the practice on the question of patent infringement to be as it is, it is advisable that the five claims before this Court are not too many to properly protect plaintiff's interests. The Patent Office has not raised any question as to the number of claims, but if the Court should feel that there are too many, contrary to our belief, plaintiff suggests that claims 25 and 28 be retained if any are to be eliminated.

2. Are the Interests of Watson (a Party to an Interference with Eger in the Patent Office) Adversely Affected by This Proceeding and Should Watson Have Been Made a Party Hereto?

Our answer to both of the above questions is in the negative for the following reasons:

We have shown in our briefs herein that there is no estoppel involved because of the fact that there was an in-

interference between Eger and Watson. If this is true, then the Watson patents have the same prior art status as if there had been no interference. Under these circumstances, Eger would have an undisputed right to antedate Watson's filing date by affidavits under Rule 75. Such affidavits were filed and their sufficiency for this purpose has never been questioned. In addition, Eger produced Mr. Ternes at the trial and he reaffirmed his affidavit and also pointed out (App., 19, Qs. 40-3) that the drawing attached to his affidavit was the same as that of the application, that it was made prior to July 1, 1932, that he saw an Eger valve prior to July 1, 1932, and that the valve which he saw was identical with the construction shown in the application drawing. This conforms in every way to the requirements of Rule 75 and, in addition, Mr. Ternes was presented at the trial for cross-examination so that he could have been questioned as to the statements which he made in his affidavit and in his direct testimony.

At the argument we asked the Court to note the following cases as showing the effect which had been given in prior cases to affidavits under Rule 75:

Thacher v. Mayor and City Council of Baltimore, 219 F. 909, 910; *In Re Grieve*, 45 App. D. C. 524; 236 O. G. 1219 (C. C. A. D. C.); *In Re Leins*, 33 U. S. P. Q. 446 (Patent Office Board of Appeals).

If our contention is correct that Eger has presented "facts showing a completion of the invention in this country before the filing of the application" of the Watson patents, then these Watson patents have been removed for all purposes. Since it is admitted that the claims are patentable over the other patents cited by the Commissioner it follows that these claims should be allowed.

We have briefly recited our position because we believe it to be necessary as a preliminary to the discussion of the question as to whether or not Watson's interests will be adversely affected by, and whether or not he should have been a party to, this proceeding.

Under the circumstances recited above, Watson is in exactly the same position as any patentee referred to in Rule 75 and his interests would not be affected any more than that of any other patentee. The *patent* interests of Watson would not be adversely affected by the grant of claims before this Court because Watson's *patent* interests depend upon *his claims* and not upon any claims that might be granted to Eger. Watson does not have any claims like those before this Court, otherwise the Patent Office would have declared an interference between Watson and Eger on such claims, in which case Rule 75 would not apply. It should be noted that Rule 75 is applicable only in those cases where the reference patent discloses but does *not claim* the subject matter of the claims in question. This is another way of saying that there cannot be an interference.

Since Rule 75 is applicable only in those cases where there cannot be an interference, the proof required under Rule 75 to show a completion of the invention claimed before the filing date of the reference patent is different from that required to show priority in an interference. Under Rule 75 there is no requirement to show a reduction to practice and therefore there is no requirement to show that the device had been successfully tested. The Commissioner has not presented any case showing that Rule 75 requires proof of reduction to practice, including successful testing. That practice is peculiar to interferences and is necessarily excluded from the practice under Rule 75.

We have shown that Watson's patent interests cannot be adversely affected by the grant of the claims before this Court and it therefore remains to be shown whether any other interests of Watson would be adversely affected by the grant of such claims. The grant of these claims simply means (assuming them to be valid) that nobody, including Watson, could use the structure of these claims without plaintiff's consent. But Watson can use anything shown in his patent without infringing such claims.

The situation here is exactly parallel, in fact identical, with that where there has been a patent granted to A on a generic invention and B later gets a patent on an improvement. In such case, B cannot use his own improvement without A's consent, nor can A use B's improvement without B's consent. This is one of the oldest principles of patent law and is fundamental to the American system. It was specifically approved by the Supreme Court in *O'Reilly v. Morse*, 15 How. 62, 122, 133-4; 56 U. S. 62, decided in 1853. We know of no contrary decision since that time. This subject is fully discussed in *Thomson-Houston Co. v. Ohio Brass Co.*, 80 F. 712, 726-7 (C. C. A. 6) by no less an authority than Judge Taft, with whom also sat Judge Lurton.

We have shown above that, so far as this proceeding is concerned, Watson's *patent* interests are not adversely affected nor are his other interests any more affected than are those of other citizens.

If Watson were made a party to cases such as this, such case would be automatically transformed into an interference. As a matter of fact, Watson could have elected that the original interference proceeding be brought to this Court under Section 4915 instead of going to the Court of Customs and Patent Appeals. This is provided for in Section 4911, which gives the right of appeal to the losing party in an interference from the Board of Interference Examiners to the Court of Customs and Patent Appeals and also states that "such appeal shall be dismissed if any adverse party (Watson) to such interference * * * file notice with the Commissioner of Patents that he elects to have all further proceedings conducted as provided in Section 4915 of the Revised Statutes". Watson did not make any such election but permitted the case to be decided by the Court of Customs and Patent Appeals. That decision was in Watson's favor, whereupon the Eger case went back to the Patent Office for *ex parte* prosecution. It comes here as an *ex parte* case, as provided in Section 4915. Watson has

had his day in court and he has no more right to be a party to this proceeding than any other member of the public. The Commissioner, being a public officer, represents the public in this proceeding and in this capacity the Commissioner, of course, represents Watson as well as every other citizen.

Since the Commissioner represents the general public, Watson is as well represented in this proceeding as any other citizen and therefore there does not appear to be any reason why Watson should receive any more consideration from this Court than should be given to the rights of other citizens.

It is believed to be plain enough that Watson had no right to be a party to the *ex parte* prosecution by Eger in the Patent Office after the interference was dissolved. This 4915 action is, in effect, a continuation of the *ex parte* prosecution as an alternative procedure to the taking of an appeal to the Court of Customs and Patent Appeals. As stated by Judge Thompson in *Central Railway Signal Co. v. Jackson*, 254 F. 103, 106, this proceeding "in its main purpose and character is not only analogous to, but it is essentially, a mandamus proceeding, directed to the Commissioner of Patents, in which any party concerned may intervene *pro interesse suo*".

It is therefore respectfully submitted that the *Monsanto* case does not apply to the present situation; the interests of Watson are not affected differently from those of any other member of the public, and that Watson should not have been made a party to this proceeding.

BURGESS, RYAN AND HICKS,
Attorneys for Plaintiff-Appellant.

NEWTON A. BURGESS,
LESTER G. BUDLONG,
RALPH B. STEWART,
Of Counsel.

IN THE UNITED STATES COURT OF APPEALS

DISTRICT OF COLUMBIA.

No. 8710.

UNITED STATES RUBBER COMPANY, *Appellant*,

v.

CONWAY P. COE, Commissioner of Patents, *Appellee*.**STIPULATION AS TO ALLOWED CLAIMS.**

It is hereby stipulated by and between the parties hereto that the claims given below are correct copies of the claims which have been allowed in Eger application Ser. No. 635,209.

16. In a valve assembly, a tubular valve casing of flexible material having an internal restriction constituting a valve seat, a ferrule secured externally of said casing and terminating in the zone of said restriction to serve as a reenforcement therefor, a co-operating valve member movable in said casing for engaging said restriction, a valve stem for said valve member extending into said casing past the restriction to draw the valve member against the restriction, and a resilient connection between the valve stem and ferrule.

17. In a valve assembly, a tubular valve casing of flexible material having an internal restriction constituting a valve seat, a ferrule secured externally of said casing and terminating in alignment with said restriction to serve as a reenforcement therefor, a co-operating valve member movable in said casing for engaging said restriction, a valve stem for said valve member extending into said casing past the restriction to draw the valve member against the restriction, and a resilient connection between the valve stem and ferrule, whereby the metallic parts of the assembly are substantially confined within the ferrule and the flexibility of the remainder of the stem is unimpaired.

18. In a valve assembly, a tubular valve casing of flexible material having an internal restriction consti-

tuting a valve seat, a ferrule secured externally of said casing and terminating in the zone of said restriction to serve as a reenforcement therefor, a co-operating valve member movable in said casing for engaging said restriction, a valve stem for said valve member extending into said casing past the restriction to draw the valve member against the restriction, a sleeve secured internally of the ferrule and the end of the casing and loosely enclosing a portion of the valve stem, and a spring interposed between the sleeve and stem for urging the valve member into engagement with the restriction.

19. A valve assembly comprising a tubular valve casing of flexible material capable of considerable bending or flexing, means at one end of said casing for securing the casing to an inner tube, the material of said casing having a restriction near the end of the casing remote from the securing means, means secured near the latter end of said casing beyond said restriction with a portion outside of and reinforcing the restriction and enclosing said latter casing end for anchoring a valve stem, a valve stem extending past said restriction, a valve member attached to the inner end of said stem, and resilient means interposed between the stem and anchoring means for urging the valve member into engagement with the restriction whereby the major portion of the casing is free from valve parts.

RALPH B. STEWART,
Attorney for Appellant.

W. W. COCHRAN,
Attorney for Appellee.

Dated: Nov. 28, 1944.

UNITED STATES
COURT OF APPEALS FOR THE
DISTRICT OF COLUMBIA

FILED JUL 13 1944

Joseph W. Stuart

CLERK

BRIEF FOR APPELLEE

United States Court of Appeals

DISTRICT OF COLUMBIA

Appeal No. 8710

UNITED STATES RUBBER COMPANY, APPELLANT

v.

CONWAY P. COE, COMMISSIONER OF PATENTS, APPELLEE

APPEAL FROM THE JUDGMENT OF THE DISTRICT COURT OF THE
UNITED STATES FOR THE DISTRICT OF COLUMBIA

W. W. COCHRAN,
Solicitor, U. S. Patent Office,
Attorney for Appellee.

E. L. REYNOLDS,
Of Counsel.

INDEX

	Page
Introduction.....	1
Appellant's Application.....	2
The Watson Patents.....	2
The Knight Patent.....	2
Summary of Argument.....	3
Argument.....	3
Watson Patent No. 2,106,671 Is A Proper Reference.....	8
Location of Spring Immaterial.....	10
Conclusion.....	12
Authorities Cited:	
<i>Alexander Milburn Co. v. Davis Bournonville Co.</i> , 270 U. S. 390..	8
<i>Automatic Weighing Machine Co. v. Pneumatic Scale Corp., Ltd.</i> , 166 F. 288.....	9
<i>Blackford v. Wilder</i> , 28 App. D. C. 535, 551.....	3
<i>Cole</i> , 82 F. (2d) 405, 23 C. C. P. A. 1057.....	5
<i>Daniels v. Coe</i> , 73 App. D. C. 54, 116 F. (2d) 941.....	3
<i>Floyd v. Rohlfing</i> , 34 App. D. C. 206.....	9
<i>General Electric Co. v. Butler</i> , 205 F. 42	9
<i>Hadley v. Ellis</i> , 258 F. 984	9
<i>Karplus</i> , 97 F. (2d) 100, 25 C. C. P. A. 1192.....	5
<i>Liebmann et al v. Newcomb</i> , 269 F. 701.....	9
<i>Long</i> , 83 F. (2d) 458.....	7
<i>Minnesota Mining and Mfg. Co. v. Coe</i> , 69 App. D. C. 256, 100 F. (2d) 429.....	8
<i>Pool v. Dunn</i> , 34 App. D. C. 132.....	9
<i>Schmidt v. Clark</i> , 13 App. D. C. 111.....	9
<i>Sola</i> , 77 F. (2d) 627, 22 C. C. P. A. 1313.....	5
<i>Webster v. Fish</i> , 277 F. 593.....	9

(I)

United States Court of Appeals

DISTRICT OF COLUMBIA

Appeal No. 8710

UNITED STATES RUBBER COMPANY, APPELLANT

v.

CONWAY P. COE, COMMISSIONER OF PATENTS, APPELLEE

*APPEAL FROM THE JUDGMENT OF THE DISTRICT COURT OF THE
UNITED STATES FOR THE DISTRICT OF COLUMBIA*

BRIEF FOR THE COMMISSIONER OF PATENTS

INTRODUCTION

This is an appeal from the judgment of the District Court of the United States for the District of Columbia (10)¹ dismissing the complaint in an action under R. S. 4915 (U. S. C., title 35, sec. 63) in which the appellant sought to have the Court authorize the allowance of a patent on the application of Eger No. 635,209 (35), containing claims 24 to 28, inclusive, of that application (3-5). The refusal of the claims involves the questions of res judicata and lack of invention over prior art.

¹ The numbers in parentheses refer to pages of appellant's appendix.

APPELLANT'S APPLICATION

Appellant's application, as best shown in Fig. 2 of the drawing (39) discloses a tire valve comprising a hollow rubber stem having a bore 14 provided with a conical valve seat 13 near its upper end. The tip of the stem, beyond this seat, is provided with a metal reinforcing member 4 which serves as a mounting for a conical valve member 16, engaging the seat 13. This valve is urged against the seat by a spring 17 which is compressed between a head 19 on the end of the valve stem and the rim 18 of a retainer member 9 which is secured in the metal member 4.

THE WATSON PATENTS

The two Watson patents, Nos. 2,106,671 (80) and 2,200,785 (89) contain substantially the same disclosure, so far as the present issues are concerned, and may generally be treated as a unit. Each of these patents discloses two different types of tire valve, each comprising a hollow rubber stem having a valve seat near the top of its bore, a valve engaging the seat, a metal reinforcing member joined to the rubber stem above the seat, and a stem for the valve, extending through and guided in this reinforcing member. The two types differ in that in one of them, the valve is seated by a spring mounted below it, while in the other, the spring is above the valve and bears against a head on the valve stem. In all forms, the valve members illustrated are spherical.

THE KNIGHT PATENT

The patent to Knight No. 1,471,172 (75) discloses a tire valve member comprising a hollow stem having

a seat in its upper portion, a metal extension above the seat, and a conical valve engaging the seat and having a stem passing through and guided in the extension. The valve is seated by a spring located above the valve and engaging a head member on the valve stem.

SUMMARY OF ARGUMENT

1. The appealed claims are unpatentable to the appellant because of prior adjudication.

2. Even aside from such adjudication, appellant has failed to establish invention of the subject matter here involved prior to the filing date of the application on which Watson patent No. 2,106,671 was granted.

3. The claims are unpatentable over the Watson device in which the spring is located below the valve, as well as that in which the spring is above it.

ARGUMENT

Res Judicata

The Eger application here involved was in interference with the application on which Watson patent No. 2,200,785 was granted, and in that interference priority of invention was finally awarded to Watson. This award, in view of the settled practice, was conclusive of every question and the right to every claim that could have been presented in the interference (*Blackford v. Wilder* 28 App. D. C. 535, 551; *Daniels v. Coe* 73 App. D. C. 54, 116 F (2d 941). As was stated in the last-cited decision, "the first proceeding is res judicata on all claims that were or could have been made therein."

It is a necessary corollary of this doctrine that an unsuccessful party to an interference cannot obtain a

claim which differs only in an immaterial respect from a claim which could have been included in the interference. The thing adjudicated is the invention common to the two cases and the losing party cannot recapture a part of this invention merely by adding some obvious feature which his opponent did not happen to disclose. While this proposition seems to be denied by the appellant, it is thought to be too well settled to require extensive discussion. The matter was ruled on by this Court in *Daniels v. Coe*, supra, wherein claims 44, 46, 47, and 52 were refused solely because they did not present "a patentable distinction" over the patent granted on the application of Robie, with whom Daniels had unsuccessfully contested an interference.

The applicant seeks to avoid the *Daniels v. Coe* decision by the following statement of page 18 of his brief: "it should be noted that the respective dates involved were not even mentioned, let alone discussed and (barring an oversight) it must be assumed that Robie's effective date was in fact early enough to constitute his patent a valid reference against Daniels." This statement is incorrect. It is stated in the second paragraph of the decision that Daniels applied for a patent in 1928 and that Robie made application, *later in the year*. It is thus evident that Robie's date was not "early enough to constitute his patent a valid reference against Daniels" and that the refusal of all the claims to Daniels was based on *res judicata*. It may also be noted that the Court of Customs and Patent Appeals has repeatedly held that a losing party

to an interference is not entitled to claims which are not patentable over the disclosure of the successful party. (*In re Karplus* 97 F. (2d) 100, 25 C. C. P. A. 1192. *In re Sola* 77 F. (2d) 627, 22 C. C. P. A. 1313. *In re Cole* 82 F (2d) 405, 23 C. C. P. A. 1057).

In the present case, each of the appealed claims is readable on Fig. 5 of the Watson application (now Patent No. 2,200,785) with which appellant's case was in interference, with the single exception that the claims call for a conical valve member, while Watson shows a spherical one. Accordingly, by merely omitting the word "conical," Eger could have added these claims to the issue of the interference and obtained a decision on priority.

It is not thought that it can be seriously contended that it would require invention to replace the spherical valve of Watson by a conical one. Both types are well known, and the Knight patent shows the use of a conical valve in an assembly very closely approximating that of Watson's Fig. 5. Further, the appellant's witness, Ternes, conceded (27) that it was old to use conical valves in the tire art, and to arrange them to cooperate with rubber seats. No new or unexpected result would be derived from the use of a conical valve, such as that of Knight, in the Watson structure. The selection of a spherical or conical valve is purely a matter of choice, within the province of any mechanic.

It follows that the appealed claims clearly define no invention over subject matter which could have been included in the interference, and hence were

properly rejected on the ground of *res judicata*. The appellant relies heavily on his exhibit 1 (31) which was introduced over objection and which purports to be a memorandum, signed by Watson, of a conference at which Ternes, Watson, and others were present. If this memorandum is relied on, as it apparently is, to establish the accuracy of the statements contained in it, it seems clearly to be hearsay. The appellant's only witness, Ternes, did not prepare the memorandum but was merely present when it was dictated by some unidentified person who was not called as a witness.

However, even assuming the accuracy of the memorandum, it clearly does not constitute an admission by Watson that he did not make the invention set forth in the appealed claims. The memorandum merely states certain obvious differences between four samples presented by Watson and a particular device designed by Eger. There is clearly no admission that Watson had never invented any valve in which the spring was above the valve seat, nor that anything done by Eger was prior to Watson. Any idea that such an admission was intended is clearly negatived by the facts that, less than a month after the alleged conference, Watson filed an application (now patent No. 2,106,671) in which he disclosed, as part of his invention, several modifications in which the spring was above the seat, and that the patent obtained on this application contains claims specific to this construction. The fact that the memorandum does not represent an agreement between Watson and Eger as to priority of inventorship is also apparent from their

filing of conflicting applications and subsequent contesting of an interference.

Under the circumstances it seems clear that the exhibit 1 memorandum did not justify Eger in assuming that Watson did not claim to be the first inventor of any construction in which the spring was above the valve. The two parties obviously had not agreed on all questions, or they would not have been in interference, and since Watson's interfering application disclosed this location of the spring, Eger was clearly put on notice that Watson regarded it as part of his invention. There would have been no object in including a showing of this construction in the Watson application if, as the appellant alleges, Watson did not claim to have invented it.

In the case of *In re Long*, 83 F. (2d) 458, relied on by the appellant, the claims which the losing party finally secured could not have been made by the winning party, because of a statutory bar, and hence could not have formed counts of the interference. In the present case, however, claims including the location of the spring above the valve would have been patentable to each party except for the adverse claim of the other, which is the condition precedent to the inclusion of a claim in interference.

The present case resembles *Daniels v. Coe, supra*, in that in each case the losing party assigned as his reason for not presenting claims the allegation that his opponent had waived the right to claim their subject matter. The reasons assigned by Daniels for this allegation seem to be at least as good as those of the appellant here, but the Court held them insufficient.

It should be noted that Watson is not a party to this proceeding and has had no opportunity to be heard. It is submitted that, under these conditions, any alleged admission made by him should be very closely examined and should not be extended beyond the exact language used, and that no such admission is presented as would justify a departure from the established rule as to *res judicata* in cases of this kind.

WATSON PATENT NO. 2,106,671 IS A PROPER REFERENCE

Even if it be assumed that the doctrine of *res judicata* is not applicable, the Watson patent No. 2,106,671 remains as a reference. This patent, in Fig. 12, shows a structure fully satisfying each of the appealed claims, except for the use of a spherical valve instead of a conical one which, as above pointed out, is clearly not a matter of invention. The only question, therefore, is whether Eger has antedated this patent.

The Watson patent is effective as a reduction to practice on August 15, 1932, the date when the application was filed (*Alexander Milburn Co. v. Davis Bournonville Co.* 270 U. S. 390; *Minnesota Mining and Mfg. Co. v. Coe*, 69 App. D. C. 256, 100 F (2d) 429). The reference, therefore, can be overcome only by proof that Eger either reduced the invention to practice prior to August 15, 1932, or conceived it before that date and exercised reasonable diligence in reducing it to practice. While the appellant's brief seems to ignore the question of diligence, and to urge that conception alone is sufficient, it is well settled that it

is incumbent on an inventor who is first to conceive an invention but not to reduce it to practice to show diligence in reducing to practice beginning at a time just prior to his opponent's entry into the field (*Schmidt v. Clark*, 13 App. D. C. 111; *Automatic Weighing Machine Co. v. Pneumatic Scale Corp., Ltd.*, 166 F. 288; *Floyd v. Rohlfing* 34 App. D. C. 206; *General Electric Co. v. Butler* 205 F. 42; *Webster v. Fish* 277 F. 593). , In each of these cases the inventor who was first to conceive was held to have forfeited his right to a patent by lack of diligence in reducing to practice.

The record in this case clearly will not support a holding that Eger reduced the claimed invention to practice prior to August 15, 1932, since there is no evidence whatever of the testing of such a device, and successful tests are necessary to establish a reduction to practice (*Pool v. Dunn*, 34 App. D. C. 132; *Hadley v. Ellis*, 258 F. 984; *Liebmann et al. v. Newcomb*, 269 F. 701). Accordingly, assuming Eger to have conceived prior to August 15, 1932, he must show diligence over the period between that date and September 28, 1932, when his application was filed. This, clearly, has not been done, there being no evidence of any activity whatever on his behalf during this period. On the contrary, the affidavit of Ternes (44) which he confirmed in his testimony states that he prepared a drawing and draft of the specification for the Eger application as early as July 1, 1932—almost three months before the application was filed. The application is an extremely simple one and might easily have been filed within a week after these papers were pre-

pared. It follows that Eger has not antedated this Watson patent and that the claims are unpatentable to him regardless of the question of res judicata.

LOCATION OF SPRING IMMATERIAL

Assuming, for the purpose of argument, that the exhibit 1 memorandum constituted a conclusive agreement that Eger was the first to locate the spring above the valve and Watson the first to locate it below, the "agreement" still leaves unsettled the question as to which party was the first inventor of the subject matter common to these two structures or, in other words, whether or not Watson made the valve with the spring below it before Eger designed one with the spring above it. The question thus left open by the "agreement" was conclusively settled by the interference, so that it clearly must be taken as established that Watson completed the invention shown by appellant's exhibit 2 (33) and by Fig. 4 of patent No. 2,106,671 prior to any date to which Eger is entitled for the invention of the appealed claims. It may be noted that the witness Ternes (28) testified that the latter structure was substantially what was referred to in the "agreement" as Watson's invention.

It follows that, even if appellant's contentions as to the effect of the exhibit 1 memorandum, and as to his alleged completion of the invention prior to Watson's filing date are accepted, the structure shown by Fig. 5 of Watson is still a part of the prior art, so far as Eger is concerned, and he is not entitled to the appealed claims unless they define invention thereover.

The appealed claims present two distinctions over this Watson structure, namely, the use of a conical, instead of a spherical valve member, and the location of the spring above instead of below the valve. These two features do not coact with each other. The action of either type of valve is the same regardless of the location of the spring, and the spring, in either location, acts in the same way regardless of the specific shape of the valve. The obviousness of substituting a conical for a spherical valve has been considered above and need not be further discussed here.

The location of the spring is also thought to be clearly a matter of choice. The problem involved is simply one of urging the valve against its seat, and any mechanic would readily see that it could either be pulled from above or pushed from below. Both arrangements are old in tire valves of this type, the former being shown by Knight. No mechanical difficulty whatever would be involved in placing the spring of Watson's Fig. 5 above the valve. This figure shows a guiding member 33 corresponding exactly to Knight's guiding washer 11, and an enlargement 34 at the top of the valve stem, corresponding to the nut 15 of Knight. It would be perfectly obvious that a spring could be placed between these two members of Watson in exactly the way that the spring is placed between the two corresponding members of Knight, and that it would perform the same function as in Knight. Even the plaintiff's witness Ternes, admitted, although rather reluctantly (X Q. 85), that "it may be possible" that a mechanic would be able to place the spring of Watson's Fig. 5 above the valve.

It is thought to be clear that the appealed claims fail to define anything patentable over Watson's structure in which the spring is located below the valve.

CONCLUSION

It is submitted that the entire disclosure of Watson patent No. 2,200,785 is available as prior art against Eger, because of res judicata, and that the equivalent disclosure of patent No. 2,106,671 is also prior art because of Eger's failure to overcome the filing date of the application on which that patent was granted. The appealed claims clearly define no invention over either of these patent disclosures.

It is further submitted that even if the Watson patents are not effective as references, on those embodiments in which the spring is placed above the valve, the appealed claims are still unpatentable to Eger since they define no invention over Watson's devices in which the spring is below the valve.

It follows that the action of the Trial Court in dismissing the complaint was proper and should be affirmed.

Respectfully submitted.

W. W. COCHRAN,
Solicitor, U. S. Patent Office,
Attorney for Appellee.

E. L. REYNOLDS,
Of Counsel.

JULY 1944.

REPLY BRIEF FOR APPELLANT

IN THE

United States Court of Appeals

DISTRICT OF COLUMBIA.

—
No. 8710
—

UNITED STATES
COURT OF APPEALS FOR THE
DISTRICT OF COLUMBIA

FILED OCT 21 1944
Joseph W. Stewart

UNITED STATES RUBBER COMPANY, *Appellant*,
CLERK

v.

CONWAY P. COE, COMMISSIONER OF PATENTS,
Appellee.

—
Appeal from the Judgment of the District Court of the
United States for the District of Columbia.
—

BURGESS, RYAN AND HICKS,
Attorneys for Plaintiff-Appellant.

NEWTON A. BURGESS,
LESTER G. BUDLONG,
RALPH B. STEWART,
Of Counsel.

IN THE
United States Court of Appeals

DISTRICT OF COLUMBIA.

No. 8710.

UNITED STATES RUBBER COMPANY, *Appellant*,

v.

CONWAY P. COE, COMMISSIONER OF PATENTS,
Appellee.

Appeal from the Judgment of the District Court of the
United States for the District of Columbia.

REPLY BRIEF FOR APPELLANT.

Appellee states (Br., p. 5) that by omitting the word "conical" Eger could have added the claims in suit to the interference. Such an argument is immaterial for the simple reason in this case that Eger was not interested in any construction other than one using a conical valve. He knew that a spherical valve has no practical value in a combination such as his where the metal valve contacts with the rubber seat.

It is true that a conical valve seating against the rubber valve stem permits a greater distribution of stresses and does not sink into the rubber. A spherical valve seating against the rubber seat results in a hardening of the rubber at the line of contact and eventually results in a leakage of the air. Knowing that a spherical valve seating against a rubber seat had no practical value, Eger was not interested in getting claims broad enough to cover such a spherical valve.

Since Eger was concerned only with a structure including a conical valve and since Watson does not disclose a conical valve, it is clear that the claims in suit could not have been added to the interference because, as was admitted at the trial, Watson does not disclose any basis for the claims in suit.

Appellee (Br., p. 5) points out how easy it would be to take the valve of Knight and substitute it for a spherical valve. If such an argument were to be accepted, there could be no such thing as a patentable combination where all the elements individually were old. There is no rule of patent law more definitely settled than that there may be a perfectly good and patentable invention in combining elements, all of which are old individually, to give a structure which produces a new result or an old result in a better way.

In the present case, Eger was concerned with producing a rubber valve stem (to secure flexibility), a tight joint between the inner tube and the valve stem (by vulcanization), a sure air-tight valve in the stem (by using a conical valve to get a large contact between the metal valve and the rubber seat) and to avoid disturbance of the parts during the unavoidable flexing of the stem (by mounting the valve spring above or outside of the valve and away from the flexible portion of the valve stem). Everyone of the features mentioned above cooperates with the others and each one is essential in the construction of a serviceable and reliable valve stem. Eger was not only concerned with a valve stem having the qualities and features mentioned

above, but he also desired to produce a stem having such a construction that it could be easily assembled and wherein the valve could be replaced if damaged.

Appellee's argument as to the obviousness of taking a part from one patent and another from a second patent and so on is the usual argument against combination claims. It always seems simple to do these things after they have been done by somebody, but the test is whether it was obvious to the man who first did it. It seems clear in this case that such was not the case because the exact combination called for by the specific claims in suit does not exist in the prior art—not even in the Watson patents.

Appellee (Br., pp. 10-11) says that the location of the valve spring is a matter of choice. If we were dealing with a non-flexible stem, appellee's statements might have some force, but it is clear that such is not the case where a flexible valve stem is used. This is all pointed out by Mr. Ternes (App., pp. 22-4) and there is not a word of testimony to contradict his statements. The fact is that the placing of the spring above the valve permits a unit construction of the valve mechanism, it simplifies the structure of the stem, it reduces the length of the mechanism and it eliminates interference due to flexing of the stem. The mechanism as a whole is easier to assemble with the spring above the valve and the entire unit can be produced at lower cost than if the spring were placed below the valve.

THE WATSON PATENTS ARE NOT AVAILABLE AS REFERENCES.

It is important to remember that we are not here concerned with the requirements of the interference practice in establishing date of invention. Eger swore back of Watson under Rule 75.

As to this the Examiner said (App., p. 64):

“The above points have been considered but it is the Examiner's opinion that *since priority in the in-*

terference involving the present application and the application of the Watson patent 2,200,785 was awarded to Watson, the appellant cannot *now* overcome the Watson patent under Rule 75 or by Exhibit No. 5 of said interference.

It is *therefore* held that the Watson patent 2,200,785 is a good reference * * *." (Emphasis ours.)

It is obvious from the foregoing that the Examiner did not question the *sufficiency* of the showing, but merely held that, because priority in the interference was awarded to Watson, Eger could not now avail himself of Rule 75. In other words, the Examiner held Eger estopped to proceed under Rule 75 because of the interference.

In affirming the Examiner, the Board of Appeals said (App., p. 67), after reference to the fact that priority was decided adversely to Eger:

"We are in full agreement with the examiner's *conclusion* that Watson is a valid reference against the terms of the claims."

The Board did not mention Rule 75, but we understand its holding to be the same as the Examiner's, namely, that Eger was estopped because of the interference to proceed under Rule 75.

The answer in this case (App., p. 8) denies that plaintiff is lawfully entitled to receive a patent in view of certain prior art patents "and for the reasons given by the Examiner in his Statement on the appeal and in the decision of the Board of Appeals".

From the foregoing it is plain that the Patent Office has never taken the position that Eger's showing under Rule 75 was insufficient. The position of the Patent Office has been merely that he was estopped to proceed under Rule 75 because of the adverse decision in the interference. We have shown in our main brief that there was no estoppel and therefore it follows that if this Court agrees that there was no estoppel, the showing which Eger made under Rule

75 is quite sufficient to remove the Watson patents as references.

In addition to the showing which was made in the Patent Office and which is now before the Court as Plaintiff's Exhibit 4, Mr. Ternes testified that he was present when the memorandum (Plaintiff's Exhibit 1) was prepared and signed and that he saw Mr. Watson sign it. This same memorandum was offered by Watson as an exhibit in the interference with Eger and this would seem to foreclose any denial by Watson of its authenticity. In so far as the Patent Office is concerned, there would seem to be no doubt that this memorandum was prepared and signed as stated and the situation in the Patent Office is that the genuineness of this document is admitted by Dr. Cadwell for the plaintiff, and by Mr. Watson on his own behalf. For all purposes of this case, the proof now before the Court is much more than that required under Rule 75 to carry Eger's date back of Watson's filing date. When this is coupled with Watson's admission or disclaimer found in the memorandum of July 21, 1932 (Plaintiff's Exhibit 1), there can be no doubt that Eger has carried his date back of Watson's filing date and that Watson has admitted it was Eger's idea to have the spring above the valve and that the valve was to be conical and not spherical.

Another point for consideration is that the interference between Watson and Eger was decided on the right to make the claim and not on the question of priority in the usual sense. The count was awarded to Watson on the ground that Eger had no right to make it. If the claims in suit had been added to the interference, a motion could have been made by Eger and a holding secured that Watson had no right to make these claims and priority would have been awarded to Eger on them in the same manner as priority was awarded to Watson of the count of the interference. All of this leads to the conclusion that if the claims in suit are patentable over the references other than Watson, the claims should be given to Eger. The Exam-

iner thought that they were patentable over the other patents, as pointed out in our main brief, page 8.

In view of the foregoing, it is respectfully submitted that the judgment should be reversed and the claims granted to Eger.

Respectfully submitted,

BURGESS, RYAN AND HICKS,
Attorneys for Plaintiff-Appellant.

NEWTON A. BURGESS,
LESTER G. BUDLONG,
RALPH B. STEWART,
Of Counsel.

